# Petition

81-1869

Supreme Court, U.S.
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ALEXANDER L. STEVAS
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No.

IN THE

# Supreme Court of the United States

OCTOBER TERM, 1981

JOHNS-MANVILLE CORPORATION

and

JOHNS-MANVILLE SALES CORPORATION,

*Petitioners,*

v.

LAM, INC.,

*Respondent.*

## PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE TENTH CIRCUIT

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## QUESTIONS PRESENTED

In a suit for patent infringement, a device may be held to infringe either because it falls within the literal scope of the patent claim or, if it does not, because it nevertheless is functionally equivalent to the patented device. The doctrine of file wrapper estoppel, however, restricts a patentee in asserting infringement based upon mere equivalency if, during the course of prosecuting his application, he had narrowed the scope of his patent claim in order to overcome a rejection by the patent examiner.

The questions presented, with respect to which the courts of appeals are in conflict, are as follows:

1. Whether file wrapper estoppel is limited to circumstances where the patent examiner's rejection of the patentee's initial claim was based on unpatentability because of prior art.

2. If so, whether a court, in applying file wrapper estoppel, may substitute its own judgment for that of the patent examiner and make an independent determination that a rejection expressly based upon prior art should have been based upon vagueness or uncertainty.*

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* If the Court decides these questions adversely to petitioners, it should further consider whether treble damages and attorneys' fees may be assessed where, as here, a finding of infringement can only be reached by disregarding the stated basis for the examiner's rejection.

## PARTIES

Petitioners Johns-Manville Corporation and Johns-Manville Sales Corporation and respondent Lam, Inc., were the only parties below.

Johns-Manville Sales Corporation is a wholly-owned subsidiary of Johns-Manville Corporation, which in turn is a wholly-owned subsidiary of Manville Corporation. Aside from its other wholly-owned subsidiaries, Manville Corporation owns, directly or indirectly, interests in M-G Exploration (partnership); National Corporation for Housing Partnership; Advocate Mines Ltd.; Carribbean Asbestos Products; Cobra Friction Products Ltd.; Kingsey Falls Paper, Inc.; Polymer International N.S. Ltd.; Compagnie Financiere Eternit; Eteroutremer; Railroad Friction Products Corp.; Manufacturera e Inversionista, S.A.; Asbestos de Mexico S.A.; Shree Digvijay Cement Co., Ltd.; Asberit, S.A.; Eternit Argentina; Eternit Ltd.; S.I.R.S. (Dalami); Nigerite Ltd.; Stillwater (partnership); Glaswerk Schuller G.m.b.H.; Kisilidjan h.f.; and Dialmecon S.A. de C.V.

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## PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE TENTH CIRCUIT

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Johns-Manville Corporation and Johns-Manville Sales Corporation hereby petition for a writ of certiorari to review the judgment of the United States Court of Appeals for the Tenth Circuit in this case.[1]

### OPINIONS BELOW

The opinion of the court of appeals (App. A, *infra* ) is reported at 668 F.2d 462 (10th Cir. 1982). The opinion of the district court (App. B, *infra* ) is not officially reported but is unofficially reported at 206 U.S.P.Q. 452 (D. Colo. 1979).

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[1] "Petitioner" will be used herein to refer to either or both of the petitioners.

## JURISDICTION

The judgment of the court of appeals was entered on January 12, 1982.[2] The court's order denying rehearing (App. C, *infra*) was entered on February 26, 1982. This Court's jurisdiction is invoked under 28 U.S.C. § 1254(1).

## STATUTES INVOLVED

35 U.S.C. §§ 101, 284, and 285 in pertinent part provide:

**§ 101. Inventions patentable**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor.

. . .

**§ 284. Damages**

Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement. . . .

When the damages are not found by a jury, the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed. . . .

**§ 285. Attorney fees**

The court in exceptional cases may award reasonable attorney fees to the prevailing party.

## STATEMENT

1. This case involves a patent issued to respondent Lam, Inc., for a pendent, upwardly opening lighting fixture that is designed for indoor use with a high intensity discharge ("HID") lamp. HID lamps, which emit extremely bright light, are not

[2] The court has not issued a formal separate judgment.

new; they have been in use since the 1930's. App. A, *infra*, p. 3a. Nor are pendent, upwardly opening lighting fixtures for HID lamps particularly new. For example, Holophane Company (since acquired by petitioner Johns-Manville Corporation) long produced and marketed such a fixture. *See* App. X, 1641; App. XI, 1873, 1879-80; App. III, 425-28. [3] Until the 1960's, however, the color of light emitted by HID lamps was not suitable for general lighting needs, and they were used only outdoors or in factories, gymnasiums, and other indoor areas with high ceilings. App. A, *infra*, p. 3a. The improvement in light color achieved in the 1960's made it feasible for the first time to consider using HID lamps in indoor areas with lower ceilings. Respondent's patent covers a lighting fixture designed for such use.

An unacceptably harsh glare results when a small circle of bright light is thrown against a low ceiling. In order to be used with HID lamps in rooms with low ceilings, therefore, a pendent, upwardly opening lighting fixture requires a reflecting bowl shaped so that it throws light out at a very low angle above the rim of the bowl, thus dispersing the reflected light over the widest possible amount of ceiling space. Applying elementary concepts of plane geometry, respondent's inventors determined that a reflecting bowl shaped as an elliptical surface of revolution, with one focus of the ellipse at the light source and the other slightly above the outer rim of the bowl, would accomplish this necessary dispersal of light. [4]

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[3] "App." refers to the appendix filed in the court of appeals.

[4] An elliptical surface of revolution is a segment of an ellipse revolved about an axis that passes through one focus of the ellipse. If a light source is placed at that focus, the light will be reflected from the elliptical surface through the second focus of the ellipse. Thus, a reflecting bowl shaped as an elliptical surface of revolution with the second focus of the ellipse disposed only slightly above the upper rim of the surface, and with the light source placed at the first focus, will throw light out at a low angle above the rim of the bowl.

After developing and testing a prototype, respondent filed its patent application. Respondent stated its basic claim broadly, without reference to the specific optical shape of the reflecting bowl.[5] In a dependent claim, respondent described a lighting fixture wherein "substantially all of the light which emerges from the lighting device leaves the luminaire after no more than one reflection." Claim 6, App. VII, 997. The patent examiner rejected all of respondent's claims, pointing out that they were "vague and indefinite," that " 'the optical shape' . . . does not indicate *what* shape is referred to," and that "no patentable significance is attached to the recitation of the 'shape.' " App. A, *infra*, p. 15a. (emphasis in original). Respondent thereupon amended its basic claim, "retaining the general references to 'optical shape' and merely particularizing inner references such as 'said bowl' and 'said lip.' " *Id.* at 16a. This time the patent examiner rejected the basic claim expressly on the basis of unpatentability because of prior art, which taught the "use of a 'reflective, upwardly opening bowl . . . shaped in a manner to prevent radiation . . . from being directly emitted substantially below the horizontal plane of the bowl's upper lip.' " *Id.* The examiner concluded that the device described in respondent's application was 'unpatentable over either Einstein or Schaffer of record taken alone or especially in view of Ainsworth newly cited because of obviousness under 35 U.S.C. § 103." App. VII, 1021.

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[5] The basic claim was for "[a] luminaire for a high intensity lighting device adapted to be suspended from the ceiling, said luminaire comprising: an upwardly opening reflective bowl, terminating in a substantially circular outer lip, the diameter of said reflective bowl being greater on the outer lip than at the lower end; a base integrally disposed upon the lower end of said bowl; means to hold said device substantially axially within said bowl and arranged so that the radiation which is emitted substantially below the horizontal plane will be reflected over said outer rim; means to hold said bowl in a fixed spatial relationship, relative to said lighting device." App. A, *infra*, p. 15a.

After this second rejection, respondent's attorney met with the patent examiner to discuss the application. On the basis of the statements made by the examiner at that conference, respondent cancelled the dependent claim that had broadly recited the optical shape and narrowed its basic claim positively to recite "the optical shape of the luminaire which provides the novel photometric distribution of light from the high intensity light source." App. VII, 1028. In its narrower form, respondent's claim covered only the use of a reflecting bowl whose optical shape was identified as "an elliptical surface of revolution, one focus of which is disposed at said light source and the second focus being disposed at a point over said outer lip of said bowl." App. A, *infra*, p. 16a. This narrower claim, which was approved by the patent examiner, *id.*, constitutes the patent claim at issue in this case.

2. In 1976, petitioner obtained and reviewed bid specifications and a brochure, both of which described respondent's lighting fixture without identifying its specific optical shape. App. A, *infra*, p. 5a. Petitioner's engineers, using conventional optical shapes, devised a similar lighting fixture, but with a reflecting bowl having a different optical shape from that described in respondent's patent. Petitioner's reflecting bowl comprises the arcs of two circles having different radii and different center locations. *See* App. VIII, 1318; App. XI, 1909; App. IV, 642-43.[6] As a consequence, the optical performance of petitioner's fixture differs from that of respondent's. Whereas an elliptical surface reflects light in converging beams through a single focal point, the upper portion of petitioner's reflecting bowl reflects light in nonconverging parallel beams and the lower portion "reflects beams in a less orderly manner: they criss-cross one another and cross rays from the upper

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[6] The surface of the upper portion of the reflecting bowl was formed by revolving an arc of a circle having a radius of 31.82 inches; the surface of the lower portion was formed by revolving an arc of a circle having a radius of 8.81 inches. App. IV, 643.

surface, and they do not converge at a single focal point or a single focal arc." App. A, *infra*, p. 12a. Because of this, the optical shape of at least the upper two-thirds of petitioner's reflecting bowl may be said to approximate a parabolic surface of revolution. [7]

Even before petitioner had sold any of its newly designed lighting fixtures, respondent's attorney wrote petitioner, taking the position that sale of the fixture would infringe respondent's patent. App. X, 1689. Petitioner's patent counsel promptly examined respondent's patent and its claims. App. X, 1690. He concluded that, because of the crucial difference in optical shapes, there would be no infringement, and he so notified respondent. App. XI, 1978. Based upon this conclusion, petitioner proceeded with the manufacture and sale of its fixtures.

3. Respondent then instituted this suit for patent infringement in the United States District Court for the District of Colorado. [8] Petitioner counterclaimed, challenging the validity of the patent.

The district court, rejecting petitioner's challenge to the validity of the patent, found infringement under "the doctrine of equivalents . . . ." App. B, *infra*, p. 38a. The court stated:

> Undeniably, as a matter of geometry, a parabola and an ellipse are different. One closes and the other doesn't. However, I find and conclude that Classpak [petitioners fixture] is in every sense of the word an equivalent of

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[7] A parabolic surface of revolution would reflect nonconverging parallel beams of light. App. V, 724-25; App. XI, 1882.

[8] The jurisdiction of the district court rested upon, *inter alia*, 28 U.S.C. § 1338.

> Luxxtra [respondent's fixture] as the term "equivalent" is used in patent law.

*Id.* at 36a. *See also id.* at 38a.[9] The court did not even discuss petitioner's argument that file wrapper estoppel barred respondent from asserting infringement under the doctrine of equivalents.

4. The United States Court of Appeals for the Tenth Circuit affirmed. The court found "ample evidence that CLASSPAK is the equivalent of LUXXtra. . . ." App. A, *infra*, p. 13a. The use of different optical shapes, in the court's view, was insignificant:

> The reflector surface serves only to get the light beams up and out of the bowl at a low angle with no more than a single reflection. . . . [W]hile an elliptical surface is best because it brings the beams out to a single focal point just above the lip, a parabola or special curve could approximate the results achieved with an ellipse. . . . [Petitioner] would have us read [respondent's] claim narrowly so that a surface that was parabolic or "special" would not be considered infringing, but this we decline to do.

*Id.* at 13a-14a.

The court of appeals stated that this extension of respondent's patent monopoly to non-elliptical surfaces, *i.e.*, its extension to the dependent claim that respondent had cancelled after an interview with the patent examiner, was not barred by the

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[9] Later in its opinion, the district court incorrectly stated that "Classpak is sufficiently close to a carbon copy [of Luxxtra] that the curvature of the bowls differs so little that a full scale drawing made with a sharp pencil can hardly differentiate between the lines of the two bowls." App. B, *infra*, pp. 50a-51a. Respondent itself quite properly advised the court of appeals that on this point the district court was confused and in error, for the reflecting bowls of the two fixtures do not fit or approximate the same curve and are not congruent. *See* Appellee's Br. 36-37. The court of appeals, however, appears not to have understood this. *See* App. 4, *infra*, p. 14a.

doctrine of file wrapper estoppel. The court described the test for file wrapper estoppel as follows:

> "The law is settled that the extent of an invention is to be determined by the patent claims, together with the 'file wrapper' history in the Patent Office, and a claim which has been narrowed for the purpose of obtaining a patent cannot be expanded to include that which was eliminated. . . . The application of this doctrine, however, is limited to changes made to overcome rejections by the Patent Office for the reason that the claim was anticipated in prior art similarities. It is not applicable where the patentee encountered difficulties in the Patent Office because of particular wording and indefiniteness of the claims."

*Id.* at 14a-15a, *quoting from Eimco Corp.* v. *Peterson Filters and Eng'r Co.*, 406 F.2d 431, 438 (10th Cir. 1968), *cert. denied*, 395 U.S. 963 (1969).

The court then recited the file wrapper history of respondent's patent. As the court acknowledged, that history showed that, before respondent narrowed its claim to cover only a reflecting bowl with a specific optical shape, a broader claim had been "rejected . . . as unpatentable in light of the prior Einstein, Schaffer, and Ainsworth patents." App. A, *infra* at 16a. The court evidently believed, however, that the patent examiner had erred in basing his rejection upon unpatentability because of prior art. The court stated its opinion that respondent's amendment of its basic claim really had been necessary only "to overcome an objection of vagueness or uncertainty, not prior art." *Id.* Accordingly, the court held that respondent's patent monopoly is not restricted, in accordance with the literal scope of its claim, to lighting fixtures with reflecting bowls having the optical shape of an elliptical surface of revolution; instead, the patent monopoly extends to fixtures with bowls of a parabolic or any other shape that reflects light beams out at a low angle over the rim of the bowl. *See id.*

## REASONS FOR ALLOWING THE WRIT

File wrapper estoppel is a well-recognized limitation on the scope of patent monopolies. Whenever patent claims have been narrowed or cancelled during the course of the prosecution of a patent application, and this commonly occurs, the extent of the monopoly that the resulting patent confers upon its owner depends upon the applicability or nonapplicability of the doctrine of file wrapper estoppel. *Graham* v. *John Deere Co.*, 383 U.S. 1, 33 (1966).[10] The questions presented here, concerning the proper scope of file wrapper estoppel and the manner in which it is to be applied by the courts, therefore go to the very heart of patent law.

The courts of appeals are in conflict over these questions. The Tenth Circuit's holding that the doctrine of file wrapper estoppel is available only where there has been a rejection based upon unpatentability because of prior art is in conflict with the more liberal scope afforded that doctrine in *Motorola, Inc.* v. *United States*, 209 U.S.P.Q. 769 (Ct. Cl. 1980), *Coleco Ind., Inc.* v. *United States Int'l Trade Comm.*, 573 F.2d 1247 (C.C.P.A 1978), and *Borg-Warner Corp.* v. *Paragon Gear Works, Inc.*, 355 F.2d 400 (1st Cir. 1965), *cert. dism'd*, 384 U.S. 935 (1966). The Tenth Circuit's substitution of its own judgment for that of the patent examiner concerning the proper basis for rejection of respondent's patent claim conflicts with the refusal by the courts in *Nationwide Chemical Corp.* v. *Wright*, 584 F.2d 714 (5th Cir. 1978), and *Ekco Prods. Co.* v. *Chicago Metallic Mfg. Co.*, 347 F.2d 453 (7th Cir. 1965), to second-guess the patent examiner in similar circumstances.

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[10] File wrapper estoppel applies, moreover, without regard to whether the claim has been amended or cancelled, and without regard to whether the patent examiner's objections are contained in a formal rejection or made only at an informal conference. *See, e.g., Kaiser Industries Corp.* v. *McLouth Steel Corp.*, 400 F.2d 36, 54-55 (6th Cir. 1968), *cert. denied*, 393 U.S. 1119 (1969).

These conflicts generate uncertainty and confusion. A matter so central to the administration of the patent laws as the lawful extent of a patent monopoly should not depend, as it now does, upon the fortuity of the choice of the forum in which the patent is first tested. Nor should the extent of the monopoly conferred by a particular patent differ, as it now can, from circuit to circuit. This Court should grant review of this case in order to re-establish uniformity of decision with respect to the proper scope and manner of application of the doctrine of file wrapper estoppel.

1. Because of the difference in optical shape, petitioner's lighting fixture does not literally infringe respondent's patent claim. Infringement was found by the courts below only by recourse to the doctrine of equivalents, *i.e.*, the rule that, even in the absence of literal infringement, a device may infringe " 'if it performs substantially the same function in substantially the same way to obtain the same result.' " *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 339 U.S. 605, 608 (1949), *quoting from Sanitary Refrigerator Co.* v. *Winters*, 280 U.S. 30, 42 (1929). A patentee's reliance upon the doctrine of equivalents, however, also brings into play file wrapper estoppel: "it has long been settled that recourse may not be had to [the] doctrine [of equivalents] to recapture claims which the patentee has surrendered by amendment." *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U.S. 126, 136 (1942).

The court below erred in restricting file wrapper estoppel to circumstances where the claims sought to be recaptured had been surrendered solely to meet a rejection based upon unpatentability because of prior art. To be sure, the rejection in *Exhibit Supply* had been based upon prior art. But the logic of this Court's opinion in that case was not confined to the particular facts. To the contrary, the Court explained that file wrapper history is relevant as a guide to the construction of patent claims because it reveals just what it was that the Patent Office under-

stood the patentee to be claiming at the time the patent was granted:

> By the amendment, [the patentee] recognized and emphasized the difference between the two phrases and proclaimed his abandonment of all that is embraced in that difference. The difference which he thus disclaimed must be regarded as material, and since the amendment operates as a disclaimer of that difference it must be strictly construed against him. *As the question is one of construction of the claim, it is immaterial whether the examiner was right or wrong in rejecting the claim as filed.* It follows that what the patentee, by a strict construction of the claim, has disclaimed . . . cannot now be regained by recourse to the doctrine of equivalents. . . .

*Id.* at 136-37 (citations omitted; emphasis added). The doctrine of file wrapper estoppel therefore stands for the basic proposition that a patentee, having induced the issuance of a patent by narrowing his claim, is not entitled to a monopoly any broader than that he himself has described.

Since "it is immaterial whether the examiner was right or wrong in rejecting the claim as filed," *id.* at 137, *a fortiori* the basis for the rejection, whether prior art, vagueness, or otherwise, also is immaterial. As the First Circuit explained in *Borg-Warner*, 355 F.2d at 406:

> If an applicant who accedes to a demand based on the prior art is thereafter estopped to contest its necessity, he should equally be estopped to deny the correctness of a demand for which some other reason is given. To a party examining the file to determine the true scope of what has been granted, and finding something affirmatively disclaimed, it should make no difference what was the purpose of the disclaimer.

Thus, in *Motorola*, 209 U.S.P.Q. at 775, the Court of Claims held that file wrapper estoppel barred recourse to the doctrine of equivalents when claims had been amended in response to a rejection based upon lack of specificity as required by 35

U.S.C. § 112. And in *Coleco Industries*, 573 F.2d at 1257-58, the Court of Customs and Patent Appeals extended file wrapper estoppel to cover all statements made on the record during prosecution of the patent application.

The decision below, which adheres without explanation to prior Tenth Circuit law, *see* App. A, *infra*, pp. 14a-15a, thus continues a conflict among the courts of appeals.[11] The volume of patent litigation in which the issue of file wrapper estoppel arises guarantees that the question is not one that will simply go away. *See generally* Barrett, *The Applicability of the Doctrine of File Wrapper Estoppel to Prevent Recapture of Abandoned Patent Claims*, 54 St. John's L. Rev. 767 (1980). This Court should grant review to resolve the conflict and clarify that the doctrine of file wrapper estoppel is not artificially delimited in the manner prescribed by the court below.

2. The court of appeals did not merely restrict file wrapper estoppel to those cases where the patent examiner's rejection was based upon prior art. It went further, and refused to accept the patent examiner's own stated basis for his rejection of respondent's claim. The patent examiner had specifically based his rejection upon unpatentability because of prior art. *See* pp. 4-5, *supra*. Yet the court of appeals disregarded what the examiner had said and substituted its own contrary view that the only problem with respondent's basic claim had been "vagueness or uncertainty, not prior art." App. A, *infra*, p. 16a.

The court evidently believed that respondent, in amending its claim, had given up more than was necessary just to meet prior

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[11] A number of other courts apparently side with the Tenth Circuit. *See, e.g.*, Cohn v. Coleco Indus., Inc., 558 F.2d 53 (2d Cir. 1977); Trio Process Corp. v. Goldstein's Sons, 461 F.2d 66 (3d Cir.), *cert. denied*, 390 U.S. 946 (1968); Ziegler v. Phillips Petroleum Co., 483 F.2d 858 (5th Cir.), *cert. denied*, 414 U.S. 1079 (1973); Laser Alignment, Inc. v. Woodruff & Sons, Inc., 491 F.2d 866 (7th Cir.), *cert. denied*, 419 U.S. 874 (1974).

art. [12] But the very purpose of file wrapper estoppel is to foreclose a patentee, once he has narrowed his claim in response to objections by the patent examiner, from later arguing that the examiner erred in requiring the amendment or that the amendment described the claim more narrowly than was necessary to meet the objections. *See Exhibit Supply Co.*, 315 U.S. at 137. File wrapper estoppel thereby operates to foreclose the courts from second-guessing the examiner and from embarking upon an excursion into the question whether the patentee should have been required to narrow his claim and, if so, by how much. By substituting its own judgment for that of the patent examiner, the court below nullified the entire doctrine of file wrapper estoppel.

The court of appeals should have been guided by the Fifth Circuit's decision in *Nationwide Chemical Corp.* There, as here, a patentee had argued that in amending its claim it had given up more than was necessary. The Fifth Circuit pointed out that "[t]he difficulty [with this argument] . . . is that it would cause us to place ourselves in the Examiner's place, and either guess what he would have allowed if faced with the question, or substitute our judgment for that of the Examiner, who is the expert in this field." 584 F.2d at 718. The Fifth Circuit properly refused to do so. Instead, it followed the lead of the Seventh Circuit in *Ekco Products:*

> [In that case], the court "looked no further than to learn whether the patentee was forced to introduce such element

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[12] The court stated that "[n]owhere in the patent examiner's rejection of the general luminaire claim does he suggest that he rejected the claim because of any relevant prior art relating to the shape of the reflector surface." App. A, *infra*, p. 16a. Thus, the court thought that respondent could have specified several or any of a number of optical shapes. The patentability of other optical shapes, however, would have been a matter for the patent examiner to decide in the first instance. The significant fact is that respondent consciously chose to limit its claim to a single, specific optical shape in order to overcome the examiner's repeated rejections.

> to avoid rejection." 347 F.2d at 454. Where such is the case, the patentee "is held strictly to the letter of the limited claims granted to him; . . . ." *Id.* at 455.

584 F.2d at 719.

The variant approach taken by the court below not only creates a conflict among the courts of appeals but also causes uncertainty and substantial unfairness. If a court may second-guess the basis for the patent examiner's actions, parties will no longer be able to use file wrapper history as a reliable guide to the scope of a patent monopoly. In this case, for example, although the file wrapper history plainly indicated that respondent had narrowed its claim to cover only a specific optical shape in the face of a rejection expressly based upon prior art, petitioner has been held to have infringed by virtue of using an entirely different optical shape.

As a result of this finding of infringement through the subjective doctrine of equivalents, and contrary to the principles of certainty and fairness that inhere in the doctrine of file wrapper estoppel, petitioner not only has been barred from selling its own product, it has been made liable for attorneys' fees and treble damages. *See* App. A, *infra*, pp. 17a-20a. These extraordinary penalties normally are imposed only where infringement was "conscious and willful," *Union Carbide Corp.* v. *Graver Tank & Mfg. Co.*, 282 F.2d 653, 673 (7th Cir. 1960), *cert. denied*, 362 U.S. 812 (1961), and not where infringement is found only under the doctrine of equivalents. No one could have anticipated the Tenth Circuit's novel and unprecedented decision to disregard the accepted guidelines for applying file wrapper estoppel. In effect, petitioner has been penalized for conscious and willful infringement where, by virtue of the traditional doctrine of file wrapper estoppel, patent lawyers would have detected no infringement at all.

## CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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# Appendix

# APPENDIX A

**UNITED STATES COURT OF APPEALS**
**TENTH CIRCUIT**

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**No. 83-1060**

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LAM, INC.,

*Plaintiff-Appellee,*

v.

JOHNS-MANVILLE CORPORATION AND
JOHNS-MANVILLE SALES CORPORATION,

*Defendants-Appellants.*

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**Appeal From The United States Court**
**For The District of Colorado**
**(D.C. No. 76-W-1216)**

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Before HOLLOWAY, LOGAN and SEYMOUR, Circuit Judges.

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LOGAN, Circuit Judge.

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Defendants Johns-Manville Corporation and Johns-Manville Sales Corporation (collectively, J-M) appeal from a trial court judgment that they infringed a patent held by Lam, Inc. The court awarded Lam treble damages and attorneys' fees, and enjoined J-M from subsequent infringement.

Lam's patent, No. 3,950,638, issued on April 13, 1976, is for a lighting fixture (luminaire) that permits indoor use of a high intensity discharge (HID) lamp in rooms of average ceiling height. The first of the patent's two independent claims — for a luminaire with a fluted reflective bowl — is not at issue here. The second independent claim, number four of the patent, reads as follows:

> "A luminaire for a high intensity lighting device said luminaire comprising: an upwardly opening reflective bowl, terminating

> in a substantially circular outer lip, the diameter of said reflective bowl being greater on the outer lip than at the lower end; a base integrally disposed on the lower end of said bowl; means for holding a high intensity lighting device substantially axially within said bowl and arranged so that the radiation which is emitted substantially below the horizontal plane of said outer lip will be reflected over said outer lip and means to hold said bowl in a fixed spatial relationship relative to said lighting device, the optical shape of said bowl being an elliptical surface of revolution, one focus of which is disposed at said source and the second focus being disposed at a point over said outer lip of said bowl."

The trial court found infringement of that claim and of claims eight and nine, dependent on claim number four:

> "8. The luminaire according to claim 4 wherein a refractor is arranged upon the base.
>
> "9. A luminaire according to claim 4 wherein substantially all radiation from said lighting device leaves the luminaire after no more than one reflection, thereby substantially eliminating trapping of the radiation with the luminaire or reflection through said lighting device."

In general, the patent claims describe a fixture intended to permit indoor use of an HID lamp by placing it in an upwardly opening luminaire having an elliptically surfaced bowl. The bowl is designed to reflect light beams out to a focal point just over the lip of the bowl, thereby dispersing the beams as closely to the horizontal as possible. As part of the fixture, a refractor may be placed at the base of the bowl, which will bend downward beams back up and out. The shape of the bowl prevents trapping and inefficiency by reflecting nearly all beams out of the bowl after a single reflection.

The principal dispute focuses upon the reflector's elliptical surface. As perhaps its main argument, J-M contends that its own reflector, otherwise nearly identical, does not infringe because the surface of its bowl is parabolic, or at least "closely approximates a parabolic surface."

It is useful, here, to discuss the nature of the HID lamp and Lam's development of the fixture for the HID lamp. Most indoor commercial lighting today uses fluorescent lamps. Fluorescent lamps, as well as the incandescent bulbs they have generally replaced, have been

used both as direct lights (downlights) and indirect lights (uplights). HID lamps have been in general use since the 1930s and, due to recent improvements, can now serve general lighting needs. HID lamps produce extremely bright light, thus requiring considerably fewer fixtures.[1] They are also much more efficient than fluorescent or incandescent light sources, consuming only about one-tenth the energy to light the same area. To date, the HID lamps have been widely used outdoors, but because of their extreme brightness and resulting glare they have not been used indoors except in factories, gymnasiums, and other areas with high ceilings.

Beginning in 1971, Lam tried to develop a method for utilizing HID lamps in rooms with conventional ceilings. After its early efforts using direct and indirect fixtures failed, Lam hired a consulting firm headed by Thomas M. Lemons. That firm experimented with both direct and indirect fixtures. Mounting the lamp in an indirect fixture blocks direct glare from below; however, if the indirect fixture allows light rays to shine directly to the ceiling, an HID lamp will produce an objectionable bright spot. Eventually, the consultants placed the lamp in an indirect fixture and pointed it downward, then used a bowl to reflect the light beams back up and out, nearly horizontally. As finally worked out, the lamp uniformly illuminates a wide area of the ceiling; from there, the beams reflect down toward the floor, almost as if the ceiling were a light source. The elliptical surface refocuses the light at a point just above the lip of the bowl, producing a wider angle of distribution than if the beams emerged further above the bowl. The LUXXtra fixture that Lam developed contains a bowl that is 8 inches high, 20-1/2 inches wide at the base, and 24-1/4 inches wide at the rim.[2] The refractor is placed on the bottom of the bowl. The bowl's shape lets most light beams emerge after only a single

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[1] The trial court observed that two 750 watt HID lamps lit the courtroom as well as all the spotlights and fluorescent tubes normally used.

[2] These dimensions are taken from Pl. Ex. 225. According to Pl. Ex. 226 J-M's CLASSPAK fixture has identical measurements except its bowl is 8-1/4 inches high and the width at the base is 20-3/4 inches. The LUXXtra brochure, Pl. Ex. 5-2, has some slightly different measurements. J-M's brief indicates the contours of the CLASSPAK and LUXXtra reflectors differ "as much as a quarter of an inch." Appellants' Br. 17.

reflection and thereby avoids trapping of the beams. As a consequence, the LUXXtra luminaire is very efficient, using over seventy percent of the light emitted by the HID lamp. The final design followed many earlier efforts, and it was late 1972 before Lam was satisfied with the product. Lam applied for its patent in late 1973. [3]

During this time, J-M's research unit was also attempting to develop an indirect fixture that would permit use of HID lamps in conventional rooms. J-M aimed its efforts principally at floor and wall-mounted units, although J-M made some attempt to design a ceiling fixture. The record is contradictory as to why J-M failed to develop an acceptable ceiling fixture; the experimental units' unattractive appearance may have been as important as the technological problems encountered in avoiding unacceptable glare. Whatever the reason, one of J-M's designers testified that it is "highly desirable" yet "rather difficult" to illuminate the ceiling directly above and still achieve a wide angle of light disbursement. [4] App. V, 661.

Soon after the Lam patent was issued for the LUXXtra fixture in April 1976, the Broward County, Florida school board issued specifications for remodeling, including relighting, five elementary schools. The specifications called for Lam's LUXXtra fixtures and described the fixture's efficiency and light distribution pattern. The blueprints accompanying the specifications showed the size and shape of the LUXXtra reflector and its mounting. One of J-M's sales representatives had previously discussed the job with the lighting engineer who developed the specifications. Immediately after the

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[3] When preparing to manufacture the bowls, Lam discovered that a true elliptical shape caused production problems. Lam resolved the problems by flattening the bowl's upper six-tenths of an inch, a deviation in shape from a true ellipse of only a few thousandths of an inch. J-M argues that as a consequence Lam is not producing its luminaires in accordance with its patent, but we agree with the trial court that the flattening is a minor, customary manufacturing deviation of no real significance.

[4] In his deposition, a J-M sales manager said that J-M "had more R&D time, more people and more man-hours involved in indirect H.I.D. lighting, I'm sure, than anyone in the lighting industry and still had not one product to offer for sale because we were trying to be perfectionists and come up with a highly viable solution." App. IX, 1418.

County issued the specifications, J-M sent one of its salesmen to Florida to discuss the specifications with the engineer. They met on May 4, 1976, and the next day, through that salesman, J-M's designers had a copy of the blueprint as well as a Lam brochure that in some detail showed the size and shape of the bowl, use of a refractor on the bottom of the bowl, placement of the lamp vertically within the bowl, and use of an integral auxiliary light source to function until the lamp heats up and becomes effective. Neither the specifications nor the brochure referred to a specific shape for the reflector surface. On its cover the brochure stated, "patented optical system," and inside stated, "patents pending."

The J-M engineer who was given the blueprint and the Lam brochure, according to his own testimony, was told to design a fixture "similar to the Lam LUXXtra." He completed the design the very next day. The drawing went to production on May 7, and by May 14 J-M had calculated its costs and a selling price and was prepared to bid on the Broward County job. On May 16 J-M tested its luminaire, which J-M designated the CLASSPAK fixture, and the next day J-M's director of research took it to Florida for demonstration. On May 18 the lighting engineer recommended to the County that it add CLASSPAK to the specifications, which it did. In June the local Florida electrical contractors bid on the school job. Immediately before the contractors submitted their final bids, J-M several times lowered its bid to electrical suppliers, and the winning contractor based its bid on the CLASSPAK fixture. About two weeks later, Lam's attorney gave J-M notice of probable patent infringement. J-M responded by denying infringement and stating that at no time had it been provided with a diagrammatic representation of the LUXXtra fixture. Apparently the J-M official who sent the letter was unaware that J-M possessed the Broward County blueprint and the Lam brochure. The instant suit soon followed.

On appeal J-M contends that (1) the Lam patent is invalid because it was anticipated by prior art, it was obvious, and the subject matter was in public use or for sale for more than one year before the patent application was filed; (2) the patent is unenforceable because of Lam's bad faith misrepresentations to the patent office, including failure to bring to its attention relevant prior art; (3) J-M did not

infringe either literally or under the equivalents doctrine, in part because of file wrapper estoppel; (4) the case does not warrant award of treble damages; (5) the case is not "exceptional," within the meaning of 35 U.S.C. § 285, and thus will not permit an award of attorneys' fees; and (6) the injunction was improperly phrased to preclude J-M's use of the trade name "CLASSPAK."

## I

## VALIDITY

### A. Anticipation And Obviousness

J-M challenges the validity of the Lam patent on the following grounds: prior art anticipated Lam's luminaire, which should not be presumed valid since the patent examiner did not consider the most relevant prior art; and the luminaire, even if not anticipated by prior art, was obvious, on which issue the trial court made no finding. An inventor is not entitled to a patent if the invention was anticipated by prior art or, as of the time it was made, would have been obvious to a person having ordinary skill in that art. 35 U.S.C. §§ 102(a)-(b), 103. The factfinder must ascertain the nature of the pertinent prior art, identify the differences between the subject invention and that art, and determine whether those differences are so slight that the invention should be considered "anticipated" by prior art, or, if not anticipated, would be "obvious" to one ordinarily skilled in that art. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). The two questions — anticipation and obviousness — are related, although the latter is a broader, more general test. *See, e.g.*, Escoa Fintube Corp. v. Tranter, Inc., 631 F.2d 682, 692-93 (10th Cir. 1980).

Since determining whether an invention was either anticipated or obvious requires inquiry into the state of the art and the art may be quite technical and difficult to understand, a court may also consider secondary characteristics that suggest whether the invention was obvious. These include whether the invention quickly met with commercial success, whether it met long-recognized but unsolved needs, and whether others had attempted to solve those needs but failed. *See, e.g.*, Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966).

By statute, a patent is presumed to be valid, 35 U.S.C. § 282, but the presumption is considerably weakened if the patent examiner did not consider relevant prior art. *E.g.*, Sidewinder Marine, Inc. v. Starbuck Kustom Boats and Prods., Inc., 597 F.2d 201, 206 (10th Cir. 1979). While the ultimate issue of the patent's validity is a question of law, subissues such as nature of prior art, ordinary skill in the art, and obviousness are questions of fact not to be overturned unless clearly erroneous. *E.g.*, Central Soya Co. v. Geo. A. Hormel & Co., 645 F.2d 847, 850 (10th Cir. 1981); Norfin, Inc. v. International Business Machs. Corp., 625 F.2d 357, 364-65 (10th Cir. 1980).

J-M argues that because elliptical and parabolic surfaces are commonly used in downlights, because downlights can be turned upside down and used as indirect lights, and because HID units had been used previously in that way, Lam was remiss in failing in its patent application to cite any downlight fixtures as relevant prior art. J-M also argues that the patent examiner never considered the most relevant prior art: J-M's own Holophane '485 fixture with its elliptical reflector, initially used as a downlight but later used as an indirect light; the Wendel patent, which utilizes an elliptical reflector in a downlight; and the Harling patent, which uses in a downlight a reflector surface with both parabolic and elliptical surfaces of revolution.

Coinventor Thomas M. Lemons, testifying as an expert witness for Lam, said that in the patent application he did not cite any downlights as prior art because he believed they were irrelevant. A downlight can be turned upside down and directed at the ceiling, but it distributes light poorly, and with an HID lamp it would produce unacceptable ceiling glare. According to Lemons, developing a fixture that used an HID unit in a low-ceilinged indoor room required him to "unlearn" many principles relevant to downlights. The patent examiner apears to have agreed that downlights were irrelevant since, according to the trial court, the examiner "considered downlights in the first action [the processing of the original patent application] but thereafter dropped all reference to them." App. I, 173. The trial court found that not only was Lemons familiar with the properties of elliptical and parabolic surfaces, but they were so well-known that the patent

examiner must have known them too. As we discuss in part III B, the patent office records show the examiner's objection to the patent claims was not due to the previous use of elliptical or similar surfaces in downlights.

Equally significant, the trial court found that the patents J-M cited were not relevant prior art. The trial court found that the light distribution of the Holophane '485 and the Wendel were "far different and much less desirable." App. I, 167. Similarly, it found that the Harling patent was not relevant prior art, concluding that downlights simply have nothing to do with indirect lighting fixtures. *Id.* at 166. As the trial court points out, J-M's own inability to design a fixture suitable for low-ceilinged use of HID's and its quick copying of the LUXXtra luminaire undermine J-M's argument that its own Holophane '485 patent anticipated the Lam patent and made it obvious. Similarly, McGraw Edison, owner of the Harling patent, did not just turn it over and use it as an uplight, but instead employed outside consultants to do "a tremendous amount of photometric computation." App. V, 801. When the patent examiner does not dwell on prior downlight art that must have been known to him and the trial court finds such art irrelevant, the party charged with infringement has not overcome the presumption that the patent office made a correct determination. *Cf.* Saf-Gard Prods., Inc. v. Service Parts, Inc., 532 F.2d 1266, 1271 (9th Cir.) (presumption of patent validity strengthened when the trial court examined "the pertinent prior art and concluded that the patent was validly issued."), *cert. denied*, 429 U.S. 896 (1976).

We have no problem with the adequacy of the trial court's findings on obviousness. When, as here, the state of the art is extensive and technical, we do not expect the trial court to describe it fully. Nor do we expect the court to describe fully the knowledge of one ordinarily skilled in the field. It is enough that the trial court consider the evidence presented as to the state of the art, including prior patents, grapple with the issues, then make findings sufficient to provide the appellate court with a clear understanding of the trial court's reasoning. *See* Sidewinder Marine, Inc. v. Starbuck Kustom Boats and Prods., Inc., 597 F.2d 201, 209 (10th Cir. 1979); Price v. Lake Sales Supply R.M., Inc., 510 F.2d 388, 391 (10th Cir. 1974). Upon

review, we will not disturb these factual findings unless they are clearly erroneous.

In the case of the Lam patent, the trial court adequately considered the state of the art (including all prior art J-M cited), the differences between the prior art and the Lam invention, and the knowledge of those ordinarily skilled in the field. The court specifically concluded that LUXXtra "was not obvious to a person of ordinary skill in the art." App. I, 168. It found that while the laws of physics and geometric principles utilized were not new, "the total result of [Lam's] combination of those known laws and principles was new." *Id.* Secondary characteristics that support a finding of non-obviousness are Lam's, J-M's, and McGraw Edison's difficulty in developing a luminaire that would allow use of an HID unit in low-ceilinged rooms, and the commercial need for the unit, as evidenced by J-M's immediate design of the CLASSPAK product line, the obvious efficiencies of the unit, and its early sales success. We hold that the trial court's findings of nonanticipation and nonobviousness were not clearly erroneous.

**B. Prior Public Use Or Sale**

An inventor is not entitled to a patent if the invention was "in public use or on sale in this country more than one year prior to the date of the application for patent in the United States." 35 U.S.C. § 102(b). J-M argues that an evaluation of the fixture by Jack DeVeuve, just over one year before Lam applied for its patent, constituted "public use." DeVeuve was a lighting engineer who subsequently sought to purchase the LUXXtra fixtures for a school project.

It is well settled that "[t]he good faith use of the device or apparatus for experimental purposes is not a public use within the intent and meaning of the statute." McCullough Tool Co. v. Well Surveys, Inc., 343 F.2d 381, 394 (10th Cir. 1965), *cert. denied*, 383 U.S. 933 (1966). Although J-M says that DeVeuve had no obligation to Lam to treat as confidential the information about the LUXXtra fixture, J-M characterizes the visit as "to inspect and make light measurements of the LUXXtra fixture suspended at varying heights from the ceiling." Appellants' Br. 51. The record makes clear that DeVeuve inspected a

mock-up fixture Lam kept in a locked room. The trial court characterized the visit as "intended to obtain technical engineering comment," "to get his professional opinion on the qualities of the experimental fixture," "a visit and inspection [that] were in no way sales oriented," and noted that "sale of the fixture was not discussed nor was it in anyone's mind at that point." App. I, 160. When DeVeuve, impressed by the luminaire, asked permission for the school board members to see the mock-up, Lam refused "because the luminaire was still in the design process." *Id.*

The record clearly supports the trial court's finding that to the extent DeVeuve's visit constituted public use, it was for experimental purposes and does not invalidate the patent.

## II

## ENFORCEABILITY

J-M argues that we should refuse to enforce the Lam patent because its inventors acted in bad faith in prosecuting the patent application. Specifically, J-M argues unenforceability because the patent applicants failed to disclose the most relevant prior art and misrepresented that the luminaire could be used in rooms as low-ceilinged as eight to nine feet, when it cannot be used where ceilings are lower than about ten feet.

A court will refuse to enforce a patent if the applicant obtained it through fraud or bad faith. An applicant must fully disclose all matters reflecting adversely upon the application, "and he risks non-enforcement of his monopoly on later discovery of a failure to fulfill that obligation." True Temper Corp. v. CF&I Steel Corp., 601 F.2d 495, 501 (10th Cir. 1979). In particular, data furnished to the patent office to compare performance of the invention with prior art must be fairly and accurately presented since the patent office has no means of verifying the data. *Id.* In this Circuit, a patent will not be enforced if the applicants obtained the patent by intentional fraud, or by misrepresentations or failures to disclose amounting to gross negligence. *Id.* at 502.

Regarding the Lam patent, J-M is not alleging that the applicants submitted improper test data. Rather, J-M's principal contention is

that the applicants failed to cite downlight luminaires as prior art. However, as we have noted, Lam's consultant Lemons testified that he did not cite downlight patents because he believed they were irrelevant, a conclusion with which the trial court agreed, and the patent examiner evidently agreed as well. The trail court found "[n]othing in the record [that] suggests intent, reckless conduct or negligence on the part of the applicant in failing to cite [prior downlight art]," App. I, 173; Lemons "acted in good faith and . . . was guilty of no negligence," *id.*; and the "[a]pplicants for the patent disclosed everything concerning prior art to the examiner a reasonable person would be expected to disclose," *id.* at 175. The record supports the trial court's findings, and we do not find them clearly erroneous.

J-M contends that the applicants misrepresented their invention as usable in rooms with ceilings as low as eight to nine feet, when in fact it cannot be used in rooms with ceilings lower than ten feet high. The only evidence J-M cites to support this argument consists of the notes of Jack DeVeuve, who visited the mock-up of the LUXXtra fixture. His notes apparently recommend a clearance of seven feet four inches between the base of the fixture and the floor. Pl. Ex. 82. We do not construe those notes as proof that the fixture cannot be utilized when ceilings are lower than ten feet, nor are they evidence substantially contradicting the claim that the luminaire is suitable for "relatively low ceilings such as found in schools, offices and shops," App. I, 9, or for "rooms of average height even as low as 8 or 9 feet," *id.* at 8. There is no evidence any misrepresentation here was made intentionally or with gross negligence. We hold that the patent is fully enforceable.

## III

## INFRINGEMENT

In determining whether there is infringement, a court looks first "to the words of the claims contained in the patent and if the accused device falls clearly and definitely within those claims, infringement is made out." McCullough Tool Co. v. Well Surveys, Inc., 343 F.2d 381, 401 (10th Cir. 1965), *cert. denied*, 383 U.S. 933 (1966). A

device may infringe either "literally" by matching each feature of the patent claim, or it may infringe as the "equivalent" of the patented device. A device is "equivalent" if it "performs substantially the same function in substantially the same way to obtain the same result," Graver Tank & Mfg. Co. v. Linde Air Prods. Co., 339 U.S. 605, 608 (1950) (quoting Sanitary Refrigerator Co. v. Winters, 280 U.S. 30, 42 (1929)). However, a patent holder is estopped from asserting equivalency if he "gave up" the accused device's mode of operation in order to meet the patent office's prior art objections. This is determined by reviewing the history of the patent application as noted on the "wrapper" of the patent file; it is customarily termed "file wrapper estoppel." J-M argues that its luminaire does not literally infringe and is not the equivalent of LUXXtra, and that based upon the file wrapper history, Lam is estopped from a construction of its patent claim that would embrace a parabolic surface.

Whether a device literally infringes or is the equivalent, and whether the patent holder is subject to file wrapper estoppel, are questions of fact. We will not set aside the trial court's findings unless they are clearly erroneous. *E.g.*, Milgo Elec. Corp. v. United Business Communications, Inc., 623 F.2d 645, 656 (10th Cir.), *cert. denied*, 449 U.S. 1066 (1980); Eimco Corp. v. Peterson Filters & Eng'r Co., 406 F.2d 431, 438 (10th Cir. 1968), *cert. denied*, 395 U.S. 963 (1969). We must determine, then, whether the record supports the findings of infringement and no application of file wrapper estoppel.

**A. Infringement: Literal Or As An Equivalent**

J-M characterizes the upper portion of its reflector as parabolic and the lower portion as a "special surface." While the trial court questioned the accuracy of J-M's demonstration, J-M purportedly showed that the upper part of its bowl reflects light in beams parallel to one another. The special surface reflects beams in a less orderly manner: they criss-cross one another and cross rays from the upper surface, and they do not converge at a single focal point or a single focal arc. Even though J-M's chief of domestic patent operations, Joseph J. Kelly, testified that as a whole the side wall of the CLASSPAK reflector is not a parabola (App. VI, 932), J-M still argues that the

reflector "approximates a parabola," and that the upper part reflects beams in a parallel manner. Lam argues that standard ellipse formation techniques can reproduce J-M's reflector surface design and that the CLASSPAK fixture is a literal infringement.

We do not address the question whether the infringement was literal, however, since we find ample evidence that CLASSPAK is the equivalent of LUXXtra and that Lam is not estopped from arguing equivalency. As to equivalency, the trial court found as follows:

> "Classpak is a remarkably close copy of Luxxtra, and, if it isn't an exact copy, the doctrine of equivalents applies. . . . No more does Classpak escape the brand of an infringing device by simply 'approximating a parabola.' I find that Luxxtra is built in accordance with the allowed claims of the patent, and I find that Classpak is an equivalent of Luxxtra, infringing allowed claims 4, 8 and 9 of Lam's patent."

App. I, 165.

The CLASSPAK luminaire performs the same function, reflection of light beams, to achieve the same result, lighting of a room with an HID lamp without objectional glare.[5] In concentrating on its parabolic surface, J-M evidently argues that reflecting light beams in a parallel manner is a "different way" to achieve the same result. But we consider the "way" to be the downward placement of a lamp in an upwardly opening bowl designed to reflect the beams at an angle close to the horizontal so as to cover a wide area of the ceiling. A slight deviation is not a "different way." Our conclusion might not be the same if J-M's deviation — a surface that "approximates a parabola" rather than an ellipse — served a function not met by the patent, but none has been shown. The reflector surface serves only to get the light beams up and out of the bowl at a low angle with no more than a single reflection. Thomas Lemons testified that while an elliptical surface is best because it brings the beams out to a single focal point

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[5] In commenting on an independent laboratory's tests of the two fixtures, J-M's expert witness, Merle E. Kech, testified that "the resulting light output from a Holophane CLASSPAK and a LUXXtra reflector of this type are very similar, and they both serve in the same application to achieve the same end results." App. V, 795.

just above the lip, a parabola or a special curve could approximate the results achieved with an ellipse. App. II, 307-308; VI, 823. J-M would have us read Lam's claim narrowly so that a surface that was parabolic or "special" would not be considered infringing, but this we decline to do.[6] The trial court observed that the CLASSPAK and LUXXtra surfaces are so similar that "a sharp pencil can hardly differentiate between the lines of the two bowls," App. I, 177, and we see no utility to a parabolic surface not met by an elliptical surface. The record supports the trial court's finding that in this context a parabolic surface is "essentially equivalent" to an "elliptical surface," and we therefore affirm the trial court's conclusion that J-M's CLASSPAK fixture infringed the Lam patent.

**B. File Wrapper Estoppel**

J-M contends that the file wrapper history of the Lam patent shows Lam explicitly limited its claim to a luminaire with an elliptical surface in order to overcome the patent examiner's prior art objections. The test for "file wrapper estoppel" is as follows:

> "The law is settled that the extent of an invention is to be determined by the patent claims, together with the 'file wrapper' history in the Patent Office, and a claim which has been narrowed for the purpose of obtaining a patent cannot be expanded to include that which was eliminated. . . . The application of

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[6] J-M complains that the trial court read Lam's patent claims broadly for purposes of infringement but narrowly for purposes of anticipation and obviousness. Without characterizing the breadth of our interpretation, we agree with the trial court's finding that the CLASSPAK fixture, with its "same function, same way, same result," and virtually identical appearance, infringes the Lam patent while prior downlights did not anticipate or make obvious the invention. J-M also argues that the LUXXtra reflector is very similar to J-M's earlier Holophane '485 fixture, and that if the LUXXtra is found to infringe, the '485 should be found to anticipate. In support, J-M cites the old axiom, "that which infringes, if later, would anticipate, if earlier." Peters v. Active Mfg. Co., 129 U.S. 530, 537 (1889). We need not decide whether that axiom holds for all cases since the trial court was not clearly wrong in finding that the '485 fixture does not make obvious the use of an elliptical reflector bowl and a refractor bottom with an HID lamp, and therefore did not find compelling the similarity of the '485 fixture to the LUXXtra luminaire.

> this doctrine, however, is limited to changes made to overcome rejections by the Patent Office for the reason that the claim was anticipated in prior art similarities. It is not applicable where the patentee encountered difficulties in the Patent Office because of particular wording and indefiniteness of the claims."

Eimco Corp. v. Peterson Filters and Eng'r Co., 406 F.2d 431, 438 (10th Cir. 1968) (citations omitted), *cert. denied*, 395 U.S. 963 (1969); *accord*, Central Soya Co. v. Geo. A Hormel & Co., 645 F.2d 847, 851 (10th Cir. 1981); Sears, Roebuck & Co. v. Jones, 308 F.2d 705, 708 (10th Cir. 1962), *cert. denied*, 371 U.S. 952 (1963).

The file wrapper history of the Lam patent began on November 14, 1973, with the filing of the patent application. The basic claim, which after amendment emerged as claim four of the issued patent, read as follows:

> "A luminaire for a high intensity lighting device adapted to be suspended from the ceiling, said luminaire comprising: an upwardly opening reflective bowl, terminating in a substantially circular outer lip, the diameter of said reflective bowl being greater on the outer lip than at the lower end; a base integrally disposed upon the lower end of said bowl; means to hold said device substantially axially within said bowl and arranged so that the radiation which is emitted substantially below the horizontal plane will be reflected over said outer rim; means to hold said bowl in a fixed spatial relationship, relative to said lighting device."

App. VII, 996. That claim did not attribute any particular optical shape to the surface of the reflector bowl. Lam added several claims dependent upon the basic luminaire claim; these included using flutes in the reflective bowl and placing a refractor at the base of the bowl. *Id.* Two original dependent claims added the provisos that the luminaire emit substantially all the light after no more than one reflection and that the optical shape be an elliptical surface of revolution. By a notice dated June 15, 1974, the patent examiner rejected all claims in the initial application on the grounds that they were "vague and indefinite" and that "no patentable significance is attached to the recitation of the 'shape.' " *Id.* at 1003. Additionally, the examiner stated that " 'the optical shape' . . . does not indicate *what* shape is referred to." *Id.*

Lam amended its application on October 9, 1974, retaining the general references to "optical shape" and merely particularizing inner references such as "said bowl" and "said lip." *Id.* at 1007-08. On April 8, 1975, the claims examiner allowed the other independent claim, for a bowl with flutes, but disallowed the remaining claims. As to the basic claim for an HID luminaire, using a bowl not necessarily fluted, the examiner rejected it as unpatentable in light of the prior Einstein, Schaffer, and Ainsworth patents. At the same time the examiner said he would allow the dependent claims if Lam redrafted them to include the basic claim's limitations. As to prior art, the examiner found it teaches use of a "reflective, upwardly opening bowl . . . shaped in a manner to prevent radiation . . . from being directly emitted substantially below the horizontal plane of the bowl's upper lip. . . ." App. VII, 1021. We believe this finding means only that prior art teaches use of an indirect fixture to avoid direct emission below the horizontal.

On July 25, 1975, Lam's patent attorney submitted a second amendment, which added further description to the reflective bowl as follows: "the optical shape of said bowl being an elliptical surface of revolution, one focus of which is disposed at said light source and the second focus being disposed at a point over said outer lip of said bowl." *Id.* at 1027. Once this change was made, the patent examiner approved all claims. The general claim was renumbered as claim four of the patent as issued and is the sole independent claim Lam asserts was infringed by J-M.

Based upon our review of the file wrapper history, we are satisfied that Lam added the reference to "elliptical surface" to overcome an objection of vagueness or uncertainty, not prior art. Nowhere in the patent examiner's rejection of the general luminaire claim does he suggest that he rejected the claim because of any relevant prior art relating to the shape of the reflector surface. Therefore, Lam is not estopped from asserting that a parabolic or similar reflector surface infringes its patent.

## IV

## TREBLE DAMAGES

The patent laws permit the court to award damages up to three times the amount found necessary to compensate for the infringement. 35 U.S.C. § 284. Courts have limited the increase to instances in which the infringement was willful, and even then it is committed to the trial court's discretion. *E.g.*, Milgo Elec. Corp. v. United Business Communications, Inc., 623 F.2d 645, 665 (10th Cir.), *cert. denied*, 449 U.S. 1066 (1980). An infringer who reasonably doubted that the patent was valid has not willfully infringed the patent. *E.g.*, Eltra Corp. v. Basic Inc., 599 F.2d 745, 757 (6th Cir.), *cert. denied*, 444 U.S. 942 (1979). The trial court concluded that J-M willfully infringed Lam's patent, a conclusion we will not disturb unless we find that court abused its discretion.

We have already described the haste with which J-M marketed a fixture "similar" to LUXXtra. After spending several years trying to develop a satisfactory indirect HID fixture, J-M's engineer, working with the Florida blueprint and the Lam brochure, designed the CLASSPAK fixture, virtually identical to Lam's in a single day.

J-M personnel must have known at that time J-M was about to infringe on another's patent. The Lam brochure bore two references to patent protection. The brochure said nothing about an elliptical surface to the reflector. In designing the CLASSPAK fixture, J-M did not attempt to avoid Lam's patent claims: J-M's marketing manager for commercial lighting, Clarence C. Keller, testified that "no particular optical design went into drawing those curves." App. III, 409.

According to Keller, J-M "decided we would do the things that were necessary to get the job, or at least compete for the job. . . ." App. IV, 566. J-M competed hard to make the sale in Florida, taking the CLASSPAK there for a personal demonstration and lowering its price to suppliers several times. The picture is one of haste to compete with Lam. In its defense J-M says it would never have filled an order for the units if it had believed there was an infringement. App. VI, 914-15. As it turns out, Lam did claim infringement before J-M made the Florida sale. J-M then found that the patent read, "an elliptical

surface of revolution," determined that its CLASSPAK fixture had a parabolic surface, and obtained an opinion of no infringement from both in-house and outside counsel. Presented to us then is a case of J-M copying Lam's design,[7] but before making the first sale, investigating the claims of the Lam patent, and arriving at a colorable assertion of no infringement.

In determining whether an infringer acted in such bad faith as to merit an increase in the damages awarded against him, we consider three factors of special significance. The first is whether the infringer deliberately copied the ideas or design of another. Obviously, this would suggest intentional infringement. The second is whether the infringer, when he knew or should have known of the other's patent protection, reasonably investigated the scope of the patent and formed a good faith belief that the patent was invalid or that it was not infringed. Here, J-M's consultations with patent counsel are especially pertinent; but a "no infringement" letter from counsel is insufficient by itself. *See* Celebrity, Inc. v. A & B Instrument Co., 573 F.2d 11, 13-14 (10th Cir.), *cert. denied*, 439 U.S. 824 (1978); Hartford Nat'l Bank and Trust Co. v. E. F. Drew & Co., 188 F.Supp. 353, 361 n.41 (D. Del. 1960), *aff'd per curiam*, 290 F 2d 589 (3d Cir.), *cert. denied*, 368 U.S. 825 (1961). The timing of the inquiries to counsel, before or after manufacture and sale of the infringing device, and the strength of counsel's arguments are important. J-M's timing of its inquiries was bad, and we are not impressed with the reasons counsel gave: invalidity because of the prior art, and no infringement because the CLASSPAK fixture has a parabolic surface.

A third factor is the infringer's behavior as a party to the litigation. Strictly speaking, although an infringer's resort to meritless defenses

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[7] J-M urges us to adopt the holding of Remington Arms Co., Inc. v. Funasaw Co., Ltd., 204 U.S.P.Q. (BNA) 967 (N.D. Ill. 1979), that a design was not "copied" if infringement is found only by applying the doctrine of equivalence. *Id.* at 969. Instead, we conclude that when a party intentionally takes the ideas of another and puts them in its own "very similar" design with only nonmeaningful deviations, the party has "copied" the other's design. We observe that J-M's witness Keller characterized his engineer's efforts as "copying" Lam's design. App. VI, 914.

and dilatory tactics is not evidence of willful infringement, it suggests bad faith. *See, e.g.*, Jenn-Air Corp. v. Penn Ventilator Co., 394 F.Supp. 665, 676 (E.D. Pa. 1975). Some evidence in the record suggests that J-M litigated in good faith by diligently responding to Lam's allegations, furnishing Lam a CLASSPAK fixture, generally responding to discovery requests, and raising defenses that were at least plausible. But evidence also supports the trial court's finding that J-M "stonewalled" when Lam first mentioned infringement and threatened Lam with litigation expenses of at least $150,000. While we hesitate to attribute too much to statements made during heated discussions, like the trial court we find offensive such threats by a large company to a small one.

Reviewing the factors important to whether J-M's conduct merits an increase in damages, we believe the record supports the finding that J-M's copying was intentional.[8] J-M did not even first obtain a copy of Lam's patent and attempt to deviate meaningfully from the patent claims. Since J-M had only the blueprint and the Lam brochure, for all J-M knew, Lam's surface may have "approximated a parabola." Later, when Lam claimed infringement, J-M was able to develop plausible arguments for no infringement. But J-M did not develop those arguments until confronted by Lam. A company intending to avoid patent infringement would have investigated Lam's patent claims earlier. The record contains sufficient evidence to support the trial court's finding of intentional infringement, and we find no abuse of the trial court's discretion.

## V

## ATTORNEYS' FEES

The court may award the prevailing party attorneys' fees "in exceptional cases." 35 U.S.C. § 285. As with treble damages, the award of attorneys' fees is subject to the trial court's discretion, to be

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[8] Additionally, the trial court found that J-M engaged in "predatory bidding" to obtain the Florida job. But predatory bidding would seem to be a harm quite separate from intentional infringement. Further, the record suggests that last minute price reductions may be commonplace in construction bidding.

overturned only for abuse of discretion. *E.g.*, Milgo Elec. Corp. v. United Business Communications, Inc., 623 F.2d 645, 667 (10th Cir.), *cert. denied*, 449 U.S. 1066 (1980). Attorneys' fees are awarded to compensate the prevailing party because the losing party's misconduct was so unfair and reckless as to make it unconscionable for the prevailing party to sustain the expense of counsel. Q-Panel Co. v. Newfield, 482 F.2d 210, 211 (10th Cir. 1973). Courts generally award attorneys' fees only when they have increased damages. In this Circuit we recognize as bases for an award of attorneys' fees either willful infringement or the asssertion of sham or frivolous defenses that increase significantly the patent holder's legal expenses through unduly protracted litigation. *Id.*

We have upheld the trial court's finding that J-M willfully infringed Lam's patent. Therefore, we find no abuse of the trial court's discretion in its award of attorneys' fees.

## VI

## THE INJUNCTION AGAINST SALE OF THE CLASSPAK FIXTURE

J-M argues that the trial court's injunction is so broad that it improperly prohibits J-M from using its trademark or trade name "CLASSPAK." We think the trial court did not intend that broad a restriction. The injunction prohibited J-M "from making, using or selling the CLASSPAK fixture."[9] The injunction was aimed at the J-M luminaire that was modeled on the Lam LUXXtra fixture and properly prohibited J-M from infringing the Lam claims. J-M should be permitted to use the name CLASSPAK on a product altered to avoid infringement. *See* Plymouth Rubber Co. v. Minnesota Mining and Mfg. Co., 321 F.2d 151, 158 (1st Cir. 1963). Since we construe the trial court's use of "CLASSPAK" as merely identifying the

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[9] The trial court's injunction reads:

"Defendants, their officers, directors, agents, employees and all those in active concert or participation with them, and each of them, are enjoined against further infringement of claims 4, 8 and 9 of United States Letters Patent No. 3,950,638 and specifically are enjoined from making, using or selling the CLASSPAK fixture."

specific infringing fixture, and not as prohibiting J-M's continued use of that name on products that do not infringe Lam's patent, we see no need to modify the trial court's judgment.

AFFIRMED.

# APPENDIX B

Lam, Inc.

v. Johns-Manville Corporation, et al.

**District Court, D. Colorado**

No. 76-W-1216

Decided Sept. 19, 1979

Winner, Chief Judge.

In talking to neophyte lawyers wanting to get into the trial practice, I surprise them when I say that they should watch the trial of a patent case because, in my experience, patent cases are the best tried of all lawsuits. From that standpoint, but only from that standpoint, this is a typical patent case. Counsel for both sides were courteous, knowledgeable, well prepared, helpful and persuasive in presenting their cases. I only wish that the degree of skill evidenced by them was typical of all types of trials rather than being the norm for patent lawyers. It was a pleasure to watch real professionals do a professional job.

This is not to say that the case has been an easy one for me to try, and I confess that the subjects of plane, solid and analytical geometry were difficult for me in school, but I have found that fifty years later those concepts are more difficult to recapture than they were to understand when they first confounded my thinking.

The case has to do with a patent on a luminaire, better known to most of us as a light fixture. The arguments run the gamut of patent law, and a study of the material submitted by counsel should give a trial judge a passing acquaintanceship with most of the contentions which can be advanced in patent litigation. Study of the record also demands familiarity with conics, parabolas, hyperbolas and ellipses. Principles of light transmission, including, quite importantly, the physical laws of refraction and reflection must be understood, and terminology applied to various types of light sources comes into play.

Because I found it essential to my comprehension of the lingo of the lighting engineers and other experts who testified that I brush up a bit

on geometry and on assorted terminology which is part of their everyday language, it may be helpful to the uninitiated burdened with having to read this opinion to first generalize on what the patent is all about and to then recall some basic concepts of geometry along with a listing of some definitions. The patent is No. 3,950,638 [hereinafter patent No. 638] and the patent abstract reads:

> "A luminaire for use with high intensity discharge lamps so that such lamps can be used in rooms of average height even as low as 8 or 9 feet. The luminaire includes a suspended bowl-shaped reflector that opens towards the ceiling and prevents glare and direct viewing of the light source."

The patent was issued to S. Leonard Kent, Thomas N. Lemons and Robert T. McLeod and it was assigned to plaintiff, Lam, Inc. Plaintiff alleges infringement of claims 4, 8 and 9, and, as will be discussed later, defendants counterclaim asking a declaratory judgment declaring claims 1, 2, 3, 5, 6 and 7 to be invalid. These are the nine claims of the patent:

"1. A luminaire for high intensity lighting devices which comprises an upwardly opening reflective bowl, terminating in a substantially circular outer lip, the diameter of said reflective bowl being greater on the outer lip than on the lower end; a base integrally disposed upon the lower end of said bowl; means to hold a high intensity light source substantially axially within said bowl and arranged relative to said lip so that the radiation which is emitted substantially below the horizontal plane of said outer lip will be reflected over said outer lip; said bowl being formed of a plurality of reflective flutes and having an optical shape so that substantially all the light which emerges from the light source leaves the luminaire after no more than one reflection, thereby substantially eliminating trapping the light within the luminaire or reflection through said source.

"2. The luminaire according to claim 1 wherein a reflective refractor is disposed upon the base.

"3. The luminaire according to claim 1 wherein the bowl is supported by a plurality of radial arms extending from a socket cover which holds the socket and light source.

"4. A luminaire for a high intensity lighting device said luminaire comprising an upwardly opening reflective bowl, terminating in a substantially circular outer lip, the diameter of said reflective bowl being greater on the outer lip than at the lower end; a base integrally disposed on the lower end of said bowl; means for holding a high intensity lighting device substantially axially within said bowl and arranged so that the radiation which is emitted substantially below the horizontal plane of said outer lip will be reflected over said outer lip and means to hold said bowl in a fixed spatial relationship relative to said lighting device, the optical shape of said bowl being an elliptical surface of revolution, one focus of which is disposed at said source and the second focus being disposed at a point over said outer lip of said bowl.

"5. The luminaire according to claim 4 wherein a multiplicity of flutes are positioned vertically around the interior of said bowl.

"6. The luminaire according to claim 5 where the flutes are formed on a stamped sleeve arranged as an insert within said bowl.

"7. The luminaire according to claim 5 wherein the flutes form the bowl.

"8. The luminaire according to claim 4 wherein a refractor is arranged upon the base.

"9. A luminaire according to claim 4 wherein substantially all radiation from said lighting device leaves the luminaire after no more than one reflection, thereby substantially eliminating the trapping of the radiation with the luminaire or reflection through said lighting device."

A quick review of the claims shows that because plaintiff charges infringement of claims 4, 8 and 9, principal attention must be directed to the language of claim 4, and much trial time and argument was spent on the clause. "the optical shape of said bowl being an elliptical surface of revolution, one focus of which is disposed at said light source and the second focus being disposed at a point over said outer lip of said bowl."

Background for the case lies in definitions of geometric terms, and these definitions I obtain from the Encyclopedia of Brittanica, and from material supplied by the parties at time of trial: (a) Handbook of Mathematical Tables and Formulas, by Burington, (b) Standard Mathematical Tables by Selby, (c) IES Lighting Handbook, and (d) Prentice Hall Mathematics Series. Except for the Encyclopedia of Brittanica, this material is part of the court file in the case although some of it may not have been formally received in evidence.

Conics has to do with intersections of a circular cone with planes of various sourts. If parallel to the base of the cone, a circle results, and the circle is sometimes described as a "special ellipse." Prentice Hall Mathematics Series says:

> "A circle can be thought of as a special case of a curve known as an ellipse. To describe a circle, we start with a given point and a given positive number, and we say that the circle is the set of points whose distance from the given point is the given number. To describe an ellipse, we start with two points and a positive number, and we say that the ellipse is the set of points, the average of whose distances from the two given points is the given number."
>
> The same text continues:
>
> "As with the ellipse, the geometric definition of the hyperbola starts with to given points F-1 and F-2 and a given positive number, "a". An ellipse is a set of points, the sum of whose distances from the foci is 2a, and a hyperbola is the set of points, the differences of whose distances from the foci is 2a."

When we come to the parabola, the starting place is a single given point and a given line. The point is the focus, the line is the directrix and the parabola is the set of points, each of which is equidistant from the focus and the directrix. We all remember from grade school that when two pins are placed in a drawing board, by using a piece of string and a pencil, an ellipse can be drawn, but, by definition, as is said in Brittanica, "a parabola is an open curve of infinite extent." An ellipse closes, but a true parabola doesn't. [I have not forgotten the lighthearted testimony of Mr. Lemons that a parabola theoretically becomes an ellipse at infinity but that he couldn't testify from personal knowledge to the closure because he has never been to infinity.] This irrefutable fact of life makes incomprehensible assertions in

testimony and argument that defendant's fixture is "generally parabolic;" that it is "more or less parabolic;" or that it "approximates a parabola." Unless the laws of geometry be repealed or amended, a curve or a surface either is or it is not a parabola or parabolic.

It is time now to come to some definitions of terms used by members of the Illuminating Engineering Society, and for this I refer to Plaintiff's Exhibit 23, excerpts from the Illuminating Engineering Society Handbook. [It is to be noted that the Society was founded in 1806 at the offices of the Holophane Company, a pioneer in the lighting fixture industry. The Holophane Company was acquired by defendant in 1971, and it is now a wholly owned division of Johns-Manville.]

The two light fixtures here involved use high-intensity discharge lamps. (HID). [*sic*] These are "a general group of lamps consisting of mercury, metal halide and high pressure sodium lamps." HID lamps are much more efficient than incandescent and fluorescent lights, but they have the disadvantage of too much brilliance which means that the light source must be adequately shielded. This requirement effectively prevents the use of HID lamps in indoor downlights in low ceilinged rooms. Downlights are by definition "a small direct lighting unit that can be recessed, surface mounted or suspended." In other words, downlights just won't work with an HID lamp used on a relatively low ceiling, and this becomes quite important in the discussion to follow concerning plaintiff's claimed concealment from the patent examiner of known prior art. As I shall explain presently, plaintiff's expert didn't think and I don't think that downlights have anything to do with an indirect fixture using HID lamps. All one need do is to look directly into an HID light to understand why downlights won't work with HID lamps. At time of trial, counsel and the court had to look at the lights through a polarized sheet just as one looks at an eclipse of the sun through a similar device. Indoor downlights and HID lamps would work one with the other just about the same way a baseball could be substituted for a football in an NFL game, and a patent on a baseball's core would compare with a patent on a football's valve to just about the same extent that a patent on a downlight compares with a patent on an indirect luminaire designed to effectively use an HID lamp. Both baseballs and footballs are thrown in a game

and both downlights and indirect lights are luminaires, but the relative comparability is about the same as that of footballs and baseballs.

Coming back to the IES Handbook, the HID lamp wouldn't work in a downlight in a room of ordinary ceiling height because of direct glare which the handbook defines as "glare resulting from high luminances or insufficiently shielded light sources in the field of view or from reflecting areas of high luminance." Direct lighting is "lighting by luminaires distributing 90 to 100 percent of the emitted light in the general direction of the surface to be illuminated," and indirect lighting is "lighting by luminaries distributing 90 to 100 percent of the emitted light upward."

With low ceilings used in modern buildings, the lighting industry was unable to utilize HID lamps in downlights, and available indirect lights wouldn't work much better because of inability to obtain the very low beam angles necessary to effectively light an area without objectionable reflected light from the glare of the light bouncing back from the ceiling overhead. The IES Handbook explains. "Glare resulting from specular reflection of high luminance on polished or glossy surfaces is known as reflected glare, and , * * * it may cause discomfort." [With an HID lamp it *would* cause discomfort.] The Handbook continues, "If a surface is figured in any way (corrugated, deeply etched, or hammered) it spreads any rays it reflects," and this is generally what the flutes mentioned in the patent are all about, but plaintiff makes no argument that defendant has infringed any patent coverage having to do with flutes mentioned in 638. [The counterclaim raises questions as to the flutes.] Refraction, of course, is pretty much the opposite of reflection, and the Handbook says that refraction is "a change in the velocity of light (which occurs) when a ray leaves one material and enters another of greater or less optical density."

A parabolic reflector is one which utlizes [*sic*] the "inherent property of the parabola * * to redirect a ray of light originating at the focal point in a direction parallel to the axis." In other words, "assuming a point source at the focus of a perfect parabolic mirror, all light from the source striking the mirror would be redirected as a beam of light parallel to the axis." Defendant's laser beam trial demonstrations

showed this, but by the end of the trial defendant was talking about an "approximate parabola," and some of the carefully machined surfaces were true parabolas.

Accepting as a calculated risk the fact that these introductory efforts at a definitional background may have served only to create confusion, I reach a more direct discussion of this case and its facts. The halide HID lamp is itself an invention which came into being during the last 20 years. Its efficiency structured new goals for lighting engineers and manufacturers of light fixtures, but that same efficiency created new problems. The light intensity permitted the lamp to be used outdoors on light poles where there were few problems of glare, but indoors, the lamp was found to be suitable for use only in very high ceilinged rooms such as gymnasiums where the height of the ceiling took care of the glare problems. From the day of its invention, the efficiency of the HID lamp was an attraction to luminaire manufacturers, and, with today's energy crisis, development of a fixture which permits use of HID lamps at ordinary ceiling heights is presumably a development of great commercial value. Plaintiff's Luxxtra fixture has that value, and so does defendant's Classpak. The traditional light measurement of foot candles is in limbo, and today's measure is "equivalent sphere illumination" (ESI), and applying this more accurate test, it takes about 1/10 the energy to provide the same illumination with HID lamps as is required with other lamps. With the cost of electricity escalating the way it has been, the commercial incentive to develop an indoor luminaire which will permit use of HID lamps in rooms having conventional ceiling heights is manifest.

It is trite to say that a trial judge has an advantage in evaluating testimony because on the trial level, the judge can see and observe the witnesses. Never before have I had occasion to participate in a trial as to which the same comment can be made as to the exhibits and demonstrations. During the trial, a Luxxtra and a Classpak were mounted on pipe stands of approximate ten foot height, and they were demonstrated at several points during the trial. Defendant's expert demonstrated a laser beam in support of defendant's case, and I say without hesitation that I a... incapable of adequately describing that which I observed. Whether a similar setup could be provided the

Court of Appeals, I know not, but for me to understand the disadvantages of a luminaire using an HID lamp when the fixture does not shield the glare and the advantages of a luminaire using the high intensity lamp when there is proper shielding and light distribution necessitated the demonstrations provided by counsel. The comparability [if not identity] of the Luxxtra and Classpak stands out with visual examination and demonstration in a way I am unable to articulate and in a way which I do not perceive from an examination of construction drawings. The laser beam demonstrations were most educational, but I have not sufficient vocabulary to really explain what I saw during the examination and cross-examination of the witnesses using the laser beam device. I guess what I am trying to say concerning the light fixtures and the demonstrations is, "You have to see it to believe it." When two of these light fixtures (as I recall it each used a 750 watt lamp) light the courtroom as well as all of the existing spotlights and fluorescent tubes used daily, the potential savings over the life of the building are almost impossible to compute with rampant inflation taken into account. I have no difficulty in finding and concluding that there is an almost unlimited commercial potential for the luminaires in litigation.

Plaintiff, along with others, fully appreciated the need for development of a luminaire suitable to permit use of an HID lamp in rooms of ordinary ceiling height, and plaintiff, along with the rest of the industry, worked to design such a fixture. Reviewing Holophane's efforts, it is certain that it worked long and hard to come out with a commercially acceptable fixture which would adapt the HID lamp for use in rooms with conventional ceilings, but, prior to the instant revelation defendant's people had after the Luxxtra was sketched by defendant's representative, defendant and its engineers failed to figure out a workable indirect HID luminaire.

Plaintiff's efforts to develop a method to utilize the efficiency of an HID lamp in an indoor fixture started about 1971. A concept of a recessed HID lamp coupled with a reflector below the ceiling was tried and rejected as was a fixture suspended from the ceiling with a louvered box. After these experiments, TLA Associates, a consulting firm headed by Thomas M. Lemons, was retained to act as consultants. Repeated discussions were held among representatives of

Lam, Lemons and Robert McLeod, and it was decided to reject all experimental work performed to date. Many and varied configurations for a luminaire were studied, but conventional designs just wouldn't get the job done. As I have discussed, downlights wouldn't work and conventional indirect lights wouldn't work because of the reflected glare. What was needed was low angle beam formations, and known luminaires wouldn't provide that. What was needed was a fixture which would provide the same light with a beam at 105° as is provided at 175°, and no one knew how to do this. Evidence in the case says that combining the difficulty factor with the quantity factor brings about the conclusion that it is 570 times as difficult to provide the same light at the lower angle than it is to provide that light at 175°. Whether this is precisely so I am unsure, but I am certain that it is much, much, much more difficult to achieve the result with utilization of the lower angle, and to approximate that result through design of a luminaire presented a challenge no one had met. Both the Luxxtra and the Classpak achieve that most desirable result through a design which was never before conceived, and both almost eliminate the objectionable spot of glare when an HID lamp is used in other indirect fixtures.

After experimentation with many reflectors, about November 9, 1971, the concept of a reflector comprising an elliptical or approximately elliptical surface of revolution was tried. The reflector design was that of a bowl using the approximately elliptical surface of revolution as sidewalls. The sidewalls were designed to be fluted to direct light around and past the light source. The luminaire was designed with one focus of the ellipse at the lamp two inches below the rim of the fixture's bowl with the second focus two inches above the outer rim. When it came time to tool up for manufacturing purposes, it was discovered that the elliptical shape started to close at the upper edge of the bowl, and, to permit manufacture, the upper 6/10 of an inch of the reflector was flattened to permit removal of the spun bowl from the chuck. Craftsmen familiar with spinning or with sand castings know that such minor production changes in spinning chucks and foundry patterns are routine, and this change of the chuck at the rim of the bowl would result in a deviation of the bowl's shape from that of a true ellipse of only a few thousandths of an inch. It would have no discernible effect on the optical properties of the bowl

as a reflector for the HID lamp. To accommodate production needs, other small deviations from the optimum shape of the bowl were made, and they had to be if a spinning chuck was to be used. However, these deviations had no measurable effect on the optics of the bowl or on the function of the luminaire. They were less than the deviations occurring in most manufacturing processes.

As work progressed, the sawtooth design originally thought to be appropriate for the bottom of the bowl was discarded, and a diffusing refractor on the bottom of the bowl was substituted. It worked well to reduce the hot-spot overhead. A mockup of the fixture was made, but it was not until October, 1972, that the first fluted bowls were delivered by the spinner. This experimental fixture was set up in a locked room at Lam's place of business where experiments continued with some Rube Goldberg adaptations, incuding using a stem adjusted by a rope and pulley to adjust the height below the ceiling and including a ceiling mounted wooden disc to approximate a canopy. The ballast just sat on the floor of the secured test room, access to which was closely guarded. Only Lam's president and vice-president had keys to the test room, and others could enter, but only if permitted to do so by the president.

Defendant argues public disclosure and use because of a visit made to the test room by one DeVeuve. This came about following a telephone call from a Lam salesman to Lam's president. DeVeuve was an engineer in Boston [Lam's place of business is in a suburb of Boston]. He had inquired of the salesman as to whether Lam had gotten anywhere in pursuing development of the much needed luminaire capable of using an HID lamp and suitable for ordinary commercial use. The mockup had been completed, and Lam's officers, knowing DeVeuve's talents and reputation, wanted to get his professional opinion on the qualities of the experimental fixture. He, along with Lam's representatives, examined and tested the fixture in the locked room, and DeVeuve made both oral and written comments concerning it. His visit and his report were intended to obtain technical engineering comment, and possible sale of the fixture was not discussed nor was it in anyone's mind at that point. Indeed, the crude mockup was a far cry from anything which could be thought to have any sales potential, and DeVeuve's visit and inspection were in no

way sales oriented. However, DeVeuve was working on a job to change the lighting in a school in Andover, Massachusetts, and a request was made to let representatives of the school board look at the mockup. Lam refused because the luminaire was still in the design process, and it wasn't ready to offer for sale. [Later, inspection by Andover School representatives was allowed.]

Development continued until 1973, when the pilot run of reflectors was ordered. Prototypes were first demonstrated at a Lam sales meeting on March 23, 1973, and further problems were identified which were later corrected. It was about this time that the first Luxxtra was ordered, and actual production got underway in June of that year. The production models were manufactured in accordance with the language of the patent. The reflective bowl was used, and the exhibits at trial showed the luminaire with and without flutes. The bowl design was that of an ellipse tilted to have one focus at the axis of the light source two inches below the rim of the bowl and the second focus two inches above the rim of the bowl. The design was that of a true ellipse, but the spinning chuck took care of the production headaches which required the slight modification of the chuck to permit removal of the bowl after spinning. The hotspot above the fixture was eliminated. For the first time a fixture was produced commercially which permitted the use of an HID lamp at a room with a low ceiling. The fixture accomplished uniform light distribution overhead and light distribution throughout the room resulted from the low angle reflection derived from the use of the elliptical bowl section with the designed location of the foci. I cannot help reiterating that the resultant working level of lighting must be seen to be appreciated, and the demonstration units set up in the courtroom permitted this observation. In more technical terms, scientific testing established that the Luxxtra emitted more than 40% of the light at low angles, and based on known technology at the time of the patent, this was a tremendous achievement, the impact of which increases with the energy shortage. It is now possible for the first time to light rooms having ordinary ceiling heights with HID lamps. This is so because the low angle reflection permits the fixtures to be located closer to the ceiling than was ever before possible, and glare is reduced to the point that the lighting is excellent for working or reading. Moreover, not only is there almost a

tenfold reduction in energy consumption, but fewer fixtures are required.

I have already mentioned that Holophane saw the need and the market for an indirect HID luminaire, and that it tried, long, hard and expensively to come up with a satisfactory product. Its engineers couldn't solve the problem, and, understandably, when Holophane management learned in May, 1976 that Luxxtra indirect HID fixtures were specified by trade name for a school building in Broward County, Florida, a Holophane salesman (Chris Keller, Jr.) took off for Florida posthaste. The architect on the job was Norman Bray, and he was the one who specified Luxxtra. Bray and Keller met on May 4, and in the course of that meeting a Bray blueprint showing the Luxxtra fixture was given to Keller. The next day, the material obtained by Keller (including a Lam brochure) were delivered in Ohio to Robert Ewing, a Holophane employee, and he was requested to design a fixture "similar" to Luxxtra. Although Holophane had spent days and weeks and months and years trying to design a workable fixture, the very next day (May 6, 1976) Ewing conceived a fixture with remarkable similarities to Luxxtra, and this fixture is the alleged infringing device known under the tradename, Classpak. Amazingly,the curvature which just happened to "approximate an ellipse" was drawn that very first day with a french curve, and that curvature was never changed. Things were moving rapidly at Holophane, because the following day drawings for a chuck were prepared, and the chuck was made to the sidewall curvature thought up by Ewing after he had the Luxxtra brochure before him. The draftsman made a dimensional error of one inch in describing the length of the long radius, but in his defense, he was under extreme time pressures and it is understandable that he said the long radius was 32.8 inches instead of 31.8 inches. The chuck's manufacture was completed in five days, and the dimensional error was corrected to 31.8 inches. By May 14, 1976, Keller was ready to start his sales pitch for 500 fixtures with an estimated cost of $70 and a bid price of $150 per unit. The game plan was into the two minute drill, because Classpak was tested in two days and on May 17, 1976, a sample was delivered to Norman Bray in Florida. It took just one day to amend the job specifications to say that Classpak was an alternate to Luxxtra. A

visual examination of the Classpak and Luxxtra fixtures available at time of trial makes inconceivable any thought that Classpak was independently designed and developed by Holophane. Visually and geometrically it is a copy pure and simple, and any contention by Holophane to the contrary is not helped by the track record conclusively proven by the evidence. Holophane couldn't design a workable fixture over the years it worked on the problem, and anyone who accepts the assertion that Classpak was independently developed and designed in two weeks is a prime candidate to buy the Brooklyn bridge.

Holophane's regular markup was a bit more than 100% [the $70 cost, $150 sales price estimate results in a multiplier of 2.2]. If that typical markup had been applied to actual costs (including the HID lamp) Holophane's selling price would have been $227, but, after thrice reducing the bid price during the bidding on the Broward County school job. Holophane sold the fixtures for $155, some $72 less than they would have charged under their established pricing practices. This froze Lam out of the competition for the job, and there were only two eligible manufacturers.

It was not long after the bidding that plaintiff suspected that defendant had copied Luxxtra to get the job. The initial letter from plaintiff's attorneys to defendant was written June 16, 1976, and the following week defendant's attorneys said that there had been no copying and argued that Classpak didn't infringe because no elliptical reflector was used. I have already found that Classpak was a copy of Luxxtra, and the matter of the elliptical reflector vel non is a subject I shall talk about later. At this point, suffice it to say that defendant's people started talking about a parabolic reflector as an escape from the coverage of the patent, but as late as September 9, 1976, when defendant made its first ray trace, there was no determination that the Classpak bowl was parabolic.

Up until the time of final argument, I was under a misapprehension as to defendant's position in this case. I thought that defendant was essentially saying that even if the patent be valid, there was no infringement because a section of Classpak's bowl was a parabola and the patent covered only an ellipse. As I misunderstood the argument, because of the change in the upper fraction of an inch in

Luxxtra's bowl to meet tooling requirements, defendant said that a section of Luxxtra's bowl wasn't part of an ellipse either. During the final argument I learned that defendant's now position [*sic*] is that the Classpak bowl "approximates" a parabola. As a result of this last minute intelligence, I asked the parties to study the record to give me record references to earlier comments made by defendant as to the shape of Classpak's bowl, and then True Temper Corporation v. C.F. & I Steel Corporation was decided by the Tenth Circuit on May 31, 1979, ____ F.2d ____ , 202 USPQ 412 (No. 762106 in the Court of Appeals). I asked comment on that case, and final comment wasn't received until July of this year. The record references I have reviewed coupled with my impressions at time of trial suggest that defendant's final arguments as to the shape of the bowls and as to the geometry involved may have shifted somewhat to fit developments during trial, but I don't know that it matters much whether there was or was not a change of position so long as the final position is solidified, and I think that it is. Under defendant's position, similarities or differences between the conic sections in question may be less important than I at first thought, but nevertheless some discussion seems warranted. Undeniably, as a matter of geometry, a parabola and an ellipse are different. One closes and the other doesn't. However, I find and conclude that Classpak is in every sense of the word an equivalent of Luxxtra as the term "equivalent" is used in patent law.

Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co. (1949) 339 U.S. 605, 85 USPQ 328, is the bell cow case, and it is peculiarly in point here, Justice Jackson said:

> "In determining whether an accused device or composition infringes a valid patent, resort must be had in the first instance to the words of the claim. If acccused matter falls clearly within the claim, infringement is made out and that is the end of it.
>
> "But courts have also recognized that to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing. Such a limitation would leave room for — indeed encourage — the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach

of law. One who seeks to pirate an invention, like one who seeks to pirate a copyrighted book or play, may be expected to introduce minor variations to conceal and shelter the piracy. Outright and forthright duplication is a dull and very rare type of infringement. To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form. It would deprive him of the benefit of his invention and would foster concealment rather than disclosure of inventions, which is one of the primary purposes of the patent system.

"The doctrine of equivalents evolved in response to this experience. The essense of the doctrine is that one may not practice a fraud on a patent. Originating almost a century ago in the case of Winans v [*sic*] Denmead, 15 How. 330, it has been consistently applied by this Court and the lower federal courts, and continues today ready and available for utilization when the proper circumstances for its application arise. To temper unsparing logic and prevent an infringer from stealing the benefit of an invention a patentee may invoke this doctrine to proceed against the producer of a device 'if it performs *substantially the same function in substantially the same way to obtain the same result*' Sanitary Refrigerator Co. v. Winters, 280 U.S. 30, 42. The theory on which it is founded is that 'if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form, or shape.' Machine Co. v. Murphy, 97 U.S. 120, 125.

By happy coincidence, Graver Tank Mfg. Co. expressly says that the patent doctrine of equivalents runs contrary to the truism of geometry that things equal to the same thing are equal to each other. The case holds:

"What constitutes equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case. Equivalence, in the patent law, is not the prisoner of a formula and is not an absolute to be considered in a vacuum. It does not require complete identity for every purpose and in every respect. In determining equivalents, things equal to the same thing may not be equal to each other and, by the same token, things for most purposes different may sometimes be equivalents. Consideration must be given to the purpose for which an ingredient is used in a patent, the qualities it has when combined with the other ingredients, and the function which it is intended to perform. An important factor is whether persons

reasonably skilled in the art would have known of the interchangeability of an ingredient not contained in the patent with one that was.

> "A finding of equivalence is a determination of fact. Proof can be made in any form: through testimony of experts or other versed in the technology; by documents, including texts and treatises; and, of course, by the disclosures of the prior art. Like any other issue of fact, final determination requires a balancing of credibility, persuasiveness and weight of evidence. It is to be decided by the trial court and that court's decision, under general principles of the appellate review, should not be disturbed unless clearly erroneous. Particularly is this so in a field where so much depends upon familiarity with specific scientific problems and principles not usually contained in the general storehouse of knowledge and experience."

Classpak is a remarkably close copy of Luxxtra, and, if it isn't an exact copy, the doctrine of equivalents applies. It is identical in means, operation and result. Not only have I seen and observed the witnesses, but I stress again that I have seen and observed the fixtures and the demonstrations. Luxxtra is built with the equivalent of an elliptical surface of revolution, and the slight modification of the bowl's shape to accommodate manufacturing necessity doesn't take it out of the language of the patent. No more does Classpak escape the brand of an infringing device by simply "approximating a parabola." I find that Luxxtra is built in accordance with the allowed claims of the patent, and I find that Classpak is an equivalent of Luxxtra, infringing allowed claims 4, 8 and 9 of Lam's patent. However, this doesn't end the matter, because in a case having interesting fact similarities to the present lawsuit, as the Seventh Circuit said in Laser Alignment, Inc. v. Woodruff:

> "As the district court correctly pointed out, *a party asserting a patent's invalidity bears the burden of proving invalidity and must overcome by clear and convincing proof the presumption of validity established by 35 U.S.C. § 282*. Walt Disney Productions v. Fred A. Niles Communications Center, 369 F.2d 230, 151 USPQ 528 (7th Cir. 1966). Further, this initial presumption is strengthened where the Patent Office, before granting the patent, has considered the prior art references, or equivalent references, relied upon by the party claiming invalidity.

> Ekstrom-Carlson & Co. v. Onsrud Machine Works, Inc., 298 F.2d 765, 132 USPQ 224 (7th Cir. 1962), cert. denied, 369 U.S. 886, 133 USPQ 703; American Needle & Novelty Co. v. Schuessler Knitting Mills, 258 F.Supp. 98, 105, 150 USPQ 174, 180 (N.D. Ill. 1966)."

Nevertheless, there are many attacks which can be aimed at a presumably valid patent, and most, if not all, of those challenges are here made.

I am sure that defense counsel in any patent case would be accused of incompetence if they failed to say that prior art invalidated a patent in suit. Defense counsel here are not incompetent, and they make the challenge. Defendant talks at length about a 1967 patent (No. 3,329,812) called the Harling patent. This patent is relied on by defendant both in the conventional prior art argument and later in support of the argument that plaintiff was guilty of inequitable conduct in prosecuting the patent. I don't agree with either argument. Harling was a downlight, and I have already said that I don't think downlights have anything to do with indirect lighting fixtures. Used upside down, Harling would have to have the refractor bowl removed, and should this be done, the wide angle distribution would be lost. Demonstrations of the Holophane 485 H fixture used to illustrate Harling turned upside down prove different lighting results and resulting objectionable glare if the fixture is "strung up by its heels." If Harling taught how to build Classpak, Holophane's engineers must have skipped that class, because they couldn't figure out the problem until they got hold of the Luxxtra literature. Once more, when all is said and done, downlights are a different breed of cat from indirect lights, and Harling does not represent prior art which impinges upon the validity of 638.

Defendant's own patent, Holophane 485 H isn't prior art which invalidates 638. The focii which are so important to the success of Luxxtra are much different; the mockup which was observed during the trial demonstrates an entirely different light distribution which is much less effective than that of Luxxtra; the models sold some 40 years ago had a 36 inch stem which would have made them useless in a low ceilinged room and the angle of light distribution wasn't as flat as that of 638. Holophane 485 H didn't suggest to its owners the

solution to the problem Holophane was trying desperately to solve, and one would think that under the circumstances of this case, swallowing the argument that Holophane 485 H is controlling prior art must scratch a little as it goes down. 638 is not weakened under prior art arguments because of Holophane 485 H.

Gerhardt (No. 1,753,885) is made up of a graceful set of ellipses as illustrated in the patent. It would almost qualify as art work in an artistic sense, but it doesn't meet the requirements of prior art in the patent sense. Gerhardt is a plurality of ellipses rather than a single elliptical shape, and there is no integral bottom of the fixture. Gerhardt isn't in any way suggestive of 638 nor of 638's unique accomplishments.

Alexander (No. 1,129,438) isn't much more than remotely comparable to 638, and it certainly can't be said to be disqualifying prior art. It fails when tested against the focal points of 638, and structurally it is completely different. It uses chain suspension which is unsatisfactory in obtaining the results available by utilization of 638.

Wendel (No. 2,068,781) is even less comparable. The reflector is half-elliptical and half-spherical. The light distribution obtainable is far different and much less desirable. Defendant has not suggested a way to modify Wendel to provide 360° of low angle lighting, and that's what Luxxtra is all about. Wendel is not prior art.

Keck (No. 3,043,950) patents a street light. If turned upside down with the glass reflector, it would be blinding used as an indoor indirect light. Keck is an outstanding example of the evils the industry was trying to and Lam did solve.

Shearer (No. 3,679,982) has nothing at all to do with the claims of 638. Shearer utilizes a disposable lamp shade, and I am simply unable to understand any argument that it constitutes prior art.

German Patent No. 425,126 doesn't utilize an integral base, but, rather, it relies on a separate reflector bowl and base elements. Moreover it uses a refractive bowl coupled with a metal shell used as a diffuser. The unique low angle distribution obtained under 638 doesn't result from the German Patent. It is not prior art.

Finally, and once again as prior art and as claimed concealment from the Patent Office, defendant relies on a technical article authored by Levin and Lemons, the consultant who worked on the development of Luxxtra. The article doesn't disclose utilization of a wide angle elliptical surface of revolution applied to a light fixture. The author of the article didn't think that it was prior art, and , indeed, if he and Levin had solved the problem when the article was written. I am confident a patent application would have been made at that time.

In summation, I have considered all of the so-called prior art relied upon by defendant in support of argument that the 638 patent was anticipated by that alleged prior art. I find and conclude that the prior art did not anticipate the 638 patent, and I find and conclude that the patent should not be invalidated on that ground. I think that I have already talked enough about the industry's struggles to develop an HID luminaire which would be workable in a room having conventional ceilings to explain my finding and conclusion that Luxxtra was not obvious to a person of ordinary skill in the art. The physical laws so skillfully woven together in the development of Luxxtra are laws of antiquity. Geometric principles and the laws of reflection of light sources from geometric shapes aren't new, but the total result of the combination of those known laws and principles was new, and, emphatically, the result was synergistic. It may be that McCullough Tool Co. v. Well Surveys, Inc. (1965) 10 Cir. 343 F.2d 381, 145 USPQ 6, has been questioned in its definition of the test of patentability of a combination of known elements [see Deere & Company v. Hesston Corporation (1979) 10 Cir. 593 F.2d 956, 201 USPQ 444] but, as Judge Doyle said, "in order for the combination of old elements to prevail, there must be a synergistic effect, that is, an effect greater than the sum of the several elements taken separately." He relied, of course, on Sakraida v. Ag Pro, Inc. (1976) 425 U.S. 273, 189 USPQ 449. I doubt that combination patent law is really applicable here except insofar as the patent combines well known physical principles and laws, but, if applicable, the case comes squarely within the command of Sakraida which held that cleaning a stable with a sudden discharge of water was hardly patentable, especially in light of the ancient story of Hercules' successful accomplishment of his fifth assigned task of cleaning the stables of

Auegas in one day. The Supreme Court held in Sakraida that synergistic effect is required to uphold combination patents, and, if this patent be viewed as a combination of known physical laws, the effect was most assuredly synergistic.

I hope that my discussion concerning Lam's experiments and the security enforced to guard the experiments demonstrates that there was no public use or sale prior to November 14, 1972, which would invalidate the patent under § 102. DeVeuve's visit has been covered, and this is the only real attack defendant makes under § 102.

The need, the probability of commercial success, the inability of others to solve the problem, uniqueness and improvement over the prior art have all been discussed and all are established by the record. Any claim of invalidity because of failure to disclose "best mode" fails miserably. Insofar as plaintiff's complaint is concerned, this leaves for discussion only the equitable argument of bad faith or concealment during the prosecution of the patent. Most of this argument developed post trial as a result of True Temper Corporation v. C.F. & I Steel Corporation (decided May 31, 1979) 10 Cir ____ F.2d ____ ____ , 202 USPQ 412. The patents there in suit were on a rail anchor, and they were held invalid because of anticipation in prior art, obviousness and inequitable conduct in prosecution of the patents in the Patent Office. The applicability of True Temper to the case at bar is its discussion of inequitable conduct or bad faith. Judge Holloway said:

> "It is, of course, well established that the exercise of fraud, inequitable conduct, or bad faith in prosecution of a patent application before the Patent Office may result in unenforceability of the patent ultimately issued. See generally Admiral Corp. v. Zenith Radio Corp., 296 F.2d 708, 716, 131 USPQ 456, 462 (10th Cir.); Technograph Printed Circuits, Ltd. v. Bendix Aviation Corp., 218 F.Supp. 1,46,137 USPQ 725, 760-761 (D.Md.), aff'd 327 F.2d 497, 140 USPQ 285 (4th Cir.), cert. denied, 379 U.S. 826, 143 USPQ 465. This rule of equity stems from the paramount interest [of the public] in seeing that patent monopolies spring from backgrounds free from fraud or other inequitable conduct. Precision Instrument Manufacturing Co. v. Automotive Maintenance Machinery Co., 324 U.S. 806, 816, 65 USPQ 133, 138. Because the Patent Office lacks proper means for fully investigating patent claims,

a patent applicant stands before it in a confidential relationship. The system could not function successfully if an applicant were 'allowed to approach the Patent Office as an arm's length adversary.' Beckman Instruments, Inc. v. Chemtronics, Inc., 428 F.2d 555, 565, 165 USPQ 355, 363-364 (5th Cir.), cert. denied, 400 U.S. 956 168 USPQ 1. Instead, the applicant owes an absolute duty of full and complete disclosure of all matters reflecting adversely upon his patent. Shaffer Tool Works v. Joy Manufacturing Co., 352 F.Supp 824, 826, 175 USPQ 613, 613-614 (S.D. Tex.), and he risks non-enforcement of his monopoly on later discovery of a failure to fulfill that obligation. See Kingsland v. Dorsey, 338 U.S. 318, 319, 83 USPQ 330, 330-331 Charles Pfizer & Co. v. F.T.C., 401 F.2d 574, 159 USPQ 193 (6th Cir.), cert. denied, 394 U.S. 920, 161 USPQ 832.

"It is true that the Precision Instrument opinion refers to 'any willful act' of the applicant respecting his cause of action as grounds for denying equitable enforcement. And some cases hold that there must be some element of wrongfulness, willfulness or bad faith to cause a refusal to enforce a patent. Pfizer, Inc. v. International Rectifier Corp., 538 F.2d 180, 186, 189, 190 USPQ 273, 278-279, 280-281 (8th Cir.), cert. denied, 429 U.S. 1040; Nashua Corp. v. RCA Corp., 431 F.2d 220, 227, 166 USPQ 449, 453-454 (1st Cir.). However, because of the strong public interest in high standards of disclosure to the Patent Office, it also has been said that it may suffice to show 'nothing more than that the misrepresentations were made in an atmosphere of gross negligence as to their truth.' Norton v. Curtiss, 433 F.2d 779, 796, 167 USPQ 532, 545-546 (CCPA). Recklessness in making erroneous submissions to the Patent Office may also be sufficient to warrant a refusal to condone conduct before the Patent Office. A. H. Emery Co. v. Marcan Products Corp., 389 F.2d 11, 18, 156 USPQ 529, 533-534 (2d. Cir.), cert. denied, 393 U.S. 835, 159 USPQ 799; Deere & Co. v. Hesston Corp., 456 F.Supp 520, 524-25, 196 USPQ 238, 242-243 (D. Utah), aff'd on other grounds. ____ F.2d ____ , 201 USPQ 444 (10th Cir. 3/9/79). Xerox Corp. v. Dennison Manufacturing Co., 322 F.Supp 963, 968-69, 168 USPQ 700, 704-706 (S.D.N.Y.)

"This court upheld findings that the patentee should not be denied relief for conduct before the Patent Office in the Admiral Corporation case. We note these comments there on the standard of conduct required, 296 F.2d at 716-17, 131 USPQ at 462-463:

" 'The courts will deny relief to a patentee who has behaved unethically in his dealings with the Patent Office in connection with a patent in suit.

* * * * * * * * *

" 'If an applicant knows of prior art which plainly describes his claimed invention or comes so close that a reasonable man would say that the invention was not original but had been anticipated, he will not be excused for failure to disclose his knowledge. This case falls outside of that rule. The record sustains the findings of the trial court that Zenith solicitors acted in good faith and were under no professional obligation or moral duty to call the Andrews patent to the attention of the Patent Office while the application which resulted in 025 was pending.'

"From our consideration of the authorities and of the paramount public interest in 'seeing that patent monopolies spring from backgrounds free from fraud or other inequitable conduct and that such monopolies are kept within their legitimate scope.' Precision Instrument Mgf. Co. v. Automotive Maintenance Machinery Co., supra, 324 U.S. at 816, 65 USPQ at 138, we conclude that intentional fraud on the Patent Office is not the only ground for withholding enforcement of patents. We feel instead that a standard like that stated by the Court of Customs and Patent Appeals in Norton v. Curtiss, supra, 433 F.2d at 766, 167 USPQ at 545-546, should be applied, also refusing to enforce patents where 'misrepresentations [are] made in an atmosphere of gross negligence as to their truth,' see also Monsanto Co. v. Rohm & Haas Co., 456 F.2d 592, 597-600, 172 USPQ 323, 326-329 (3d Cir.), cert. denied, 407 U.S. 934, 174 USPQ 129, or where there is reckless conduct in representations to the Patent Office, as some case [*sic*] say.

"We note particularly that cases dealing with reporting of test results and similar data to the Patent Office have demanded a higher standard than mere avoidance of intentional fraud on the Patent Office. In Norton v. Curtiss, supra, 433 F.2d at 974, 167 USPQ at 544-545, the Court of Customs and Patent Appeals stated in terms pertinent to these appeals that:

" 'Where, as here, an applicant attempts to overcome by [*sic*] a rejection by submitting a comparative showing of properties, the very act of submitting that showing, apart of what is represented therein, must also be regarded as a representa-

> tion. The most meaningful comparison, in such instances, would be that between the claimed invention and the best embodiment of the prior art available. Therefore, in submitting evidence of comparative tests, unless the circumstances indicate the contrary, an applicant must be held to be representing that his showing includes a fair and accurate demonstration of the closest prior art of which he is aware.'
>
> "See also Monsanto Co. v. Rohm & Haas Co., supra. 456 F.2d at 597 n.10, 172 USPQ at 326-327 n.10; Carter-Wallace, Inc. v. Davis-Edwards Pharmacal Corp., 443 F.2d 867, 881, 169 USPQ 625, 634-635 (2d Cir.), cert. denied, 412 U.S. 929."

True Temper held that there was inequitable misconduct which amounted to intentional misleading and concealment of testing information. The trial judge so found and the Court of Appeals affirmed. I have already orally found on the record that there was no intent on the part of Mr. Lemons or anyone else to mislead or conceal. He honestly believed that the so-called prior art had nothing whatsoever to do with the application for 638, and factually this case just doesn't demonstrate any misconduct in the prosecution of the patent application. However, because True Temper is so recent and because it contains such a full review of the applicable principles, I think that more discussion is in order. At the outset it is to be noted that there is no testing information here allegedly concealed. Then it must be mentioned that True Temper, of course, in large part rests on Admiral Corporation v. Zenith Radio Corporation (1961) 10 Cir. 296 F.2d 708. 131 USPQ 456, albeit Judge Holloway emphasizes that affirmative misrepresentation is not required and reckless or grossly negligent conduct may suffice to nullify a patent. Nevertheless, the three pronged test of Admiral is still of importance. To say that there was inequitable conduct which nullifies the patent, it must be shown that the differences between the patent and the prior art were insignificant; that the undisclosed information was peculiarly within the knowledge of the applicant (as, for example, testing information) and that there was bad faith on the part of the applicant (or, under True Temper, that there was reckless or grossly negligent conduct.) My analysis of the evidence in this case is precisely the same as was the analysis of Judge Rizley in Admiral. The prior art so strenuously argued by defendant here "involved (1) significant differences from (the light fixture covered by 638), (2) (except for the Lemons articles) was readily

available to the patent examiner from the files of the Patent Office, and (3) the (plaintiff's) solicitors, after examining the prior art patents, acted in complete good faith in thinking it not pertinent enough to call to the attention of the Patent Office and they were under no professional obligation or moral obligation to call the patent(s) to the attention of the Patent Office."

In this case, there was no intent to conceal, there was no willful conduct on the part of Lemons or his attorneys in failing to disclose everything a reasonable man would deem to be prior art or in failing to disclose other material information nor was there any reckless or grossly negligent failure to disclose. Indeed, I don't think that there was any prior art which was not disclosed, but, if there was, the failure to disclose was entirely innocent and the failure, if any, was not negligent. I just do not buy defendant's post trial arguments that this case is comparable to True Temper, because I think that the case is on all fours with Admiral. Defendant pegs its inequitable conduct argument to, (a) the Harling patent as prior art, (b) Lemons' knowledge of the properties of elliptical surfaces, (c) his November 2, 1971, memo, (d) the statement in the course of the prosecution that, "applicants are not aware of any 'prior art' as that term is normally employed," and (e) the DeVeuve visit to the test room.

I can think of little more to say concerning the Harling patent. Lemons didn't think that downlights had anything to do with indirect lights, and seemingly the examiner must have agreed because he considered downlights in the first action but thereafter dropped all reference to them. Nothing in the record suggests intent, reckless conduct or negligence on the part of the applicant in failing to cite the Harling patent to the examiner. I am sure that no patent in recent history has issued as to which a similar attack could not be launched. Absolute good faith is required of patent applicants, but there is no requirement that overworked patent examiners be burdened with study of material a reasonable man would think was neither relevant nor material.

I have not the slightest doubt that Mr. Lemons was well informed as to the properties of elliptical surfaces and parabolic surfaces used as reflectors. Those long established principles are set forth in count-

less texts, and I had no trouble locating appropriate discussions in the Encyclopedia of Brittanica. I hope it is fair to presume that patent examiners possess the basics of scientific knowledge, and I hope that it is not required that patent applicants make written disclosure of everything taught in high school mathematics and physics classes. I just don't follow defendant's argument that Mr. Lemons was guilty of any inequitable conduct in this regard. I think that he acted in good faith and I think that he was guilty of no negligence. If defendant's argument be chased to its logical conclusion, the application should have mentioned that things heavier than air won't cling to the ceiling and that the fixture had to be suspended.

No more do I think that a reasonable man applying for this patent would have or should have mentioned either of the articles (PX 28 or DX 73) as prior art. There is affirmative testimony in the record that Mr. Lemons' failure to mention the articles was not because of any intent to conceal or misrepresent, and I cannot find negligence, let alone gross negligence or reckless conduct, in the failure to disclose. I don't think that either article can be fairly classified as prior art, and the fact that the articles weren't mentioned does not amount to inequitable conduct in the prosecution of the patent. For the most part those articles discuss possibilities rather than discovered facts.

Defendant's arguments concerning the Patent Office statement, "Actually, applicants are not aware of any 'Prior Art' as that term is normally employed," is argued out of context. The statement was based on plaintiff's assignors many experiments and many concepts tried and tested in the course of development of the fixture. Of course, if "prior art" be read to mean that all luminaires ever manufactured must be talked about, there was a failure to disclose, but that isn't what the phrase means and that isn't what the statement in the application means. Defendant's argument would require that Lemons tell the examiner that miners sometimes punch a hole in the bottom of a coffee can to permit it to be hung over a light bulb, and, presto, they have a luminaire. The statement on which defendant relies was simply the expression of a good faith belief that no luminaire had ever been developed which permitted use of an HID lamp in an indirect lighting fixture to be used in a room having a ceiling of normal height. If there was any such fixture, Mr. Lemons didn't know about it, and

defendant hasn't found it during the extensive discovery conducted in this case. Of course, in a broad, unreasonable sense there was "prior art," but taken in context the statement made was not misleading and it was not intentionally false any more that [*sic*] it was carelessly or recklessly made.

Defendant has the burden of proving misrepresentation to or concealment from the Patent Office, and this burden has not been met. It matters not whether intentional conduct, reckless conduct, grossly negligent conduct or just negligent conduct is required. None of them were proved. Applicants for the patent disclosed everything concerning prior art to the examiner a reasonable person would be expected to disclose.

Lastly, defendant tries to invalidate the patent by distorting the provisions of 35 U.S.C. § 102(b) — the "on sale" part of the statute. With the facts in mind, this argument is just makeweight, and I don't think that defendant urges it very seriously. There is not the slightest evidence that the invention was offered for sale nor is there any evidence of public use. The evidence is all convincingly to the contrary. Any finding of sale or public use would be unsupportable, and I expressly find that there was neither sale nor public use.

With what I have said, it really makes no difference whether the "but for" or some other rule be applied in evaluating defendant's efforts to invalidate the patent because of inequitable conduct. No matter what the rule, defendant has failed to meet the burden. I have said that there was no duty to disclose the information on which defendant bases its arguments, but, even if there were, I cannot think that the patent would not have issued if every tidbit of the data defendant talks about had been discussed with the examiner. The cases relied on by defendant are not in point, and the factual record in this case demands the result the Tenth Circuit reached in Admiral rather than that court's result in True Temper.

Therefore, I find and conclude that I have jurisdiction to decide the validity of and the infringement of claims 4, 8 and 9 of the United States Patent No. 3,950,938. Those claims are valid and they were infringed by defendant in its manufacture and sale of the Classpak fixture.

The declaratory judgment counterclaims I do not reach because there is no case or controversy before me concerning them. Defendant wants an advisory opinion as to the validity of claims 1, 2, 3, 5, 6 and 7, and the advisory opinion doesn't come within the limitations of a declaratory judgment action. Defendant wants a little free advice as to the validity of claims which require the use of flutes, but defendant has never manufactured any Classpak using flutes, and plaintiff makes no charge of infringement of any of the claims as to which the declaratory judgment is sought.

Courts are not created to give legal advice, and in the absence of an actual controversy, declaratory judgments aren't given. Ashcroft v. Mattis (1977) 431 U.S. 171, controls:

> "For a declaratory judgment to issue there must be a dispute which 'calls, not for an advisory opinion upon a hypothetical basis, but for an adjudication of present rights upon established facts.' "

Defendant has not manufactured and it has no definite plans to manufacture an indirect lighting luminaire utilizing flutes suitable for use with an HID lamp. Where there is neither charge of violation nor utilization or planned utilization of a claimed right there is no case or controversy. See, Sweetheart Plastics, Inc. v. Illinois Tool Works, Inc., (1971) 1 Cir. 439 F.2d 871, 168 USPQ 737; Emerson v. National Cylinder Gas Co. (1958) 1 Cir. 251 F.2d 152, 116 USPQ 101 and Moore Federal Practice, ¶ 57.20.

I have reserved ruling on plaintiff's motion to dismiss the counterclaims. That motion is now granted because I have no jurisdiction to issue an advisory opinion, declaratory of the validity of claims 1, 2, 3, 5, 6 and 7. To do so would be to rule on a non-case or controversy.

35 U.S.C § 285 says, "The court in exceptional cases may award reasonable attorneys fees to the prevailing party," and plaintiff asks that this statute be applied. It is generally held that the statute should be invoked only rarely, and that a finding of unfairness, bad faith or inequitable or unconscionable conduct is required to trigger the statute. Larchmont Engineering, Inc. v. Toggenburg Ski Center, Inc. (1971) 2 Cir. 444 F.2d 490, 170 USPQ 241; Uniflow Mfg. Co. v. King-Seeley Thermos Co. (1970) 6 Cir. 428 F.2d 335, 166 USPQ 70.

Q Panel Co. v. Newfield (1973) 10 Cir. 482 F.2d 210, 178 USPQ 521, says that attorneys fees should be allowed only in exceptional circumstances, and that they should be allowed only where a party's conduct is so unfair or reckless as to make it unconscionable for the prevailing party to sustain the expense. Citing Q-Panel Judge Breitenstein said in Halliburton Company v. Dow Chemical Company (1975) 10 Cir. 514 F.2d 377, 185 USPQ 769:

> "The award of attorney fees under § 285 is compensatory rather than punitive. Mueller Brass Co. v. Reading Industries, Inc. E.D. Pa. 352 F.Supp. 1357, 1381 aff'd 3 Cir. 487 F.2d 1395. Halliburton brought this suit. Nothing shows that it was forced into doing so by any unfair or reckless conduct of Dow. We find nothing in the record to sustain the conclusion that the conduct of Dow was so fraudulent, unfair, or reckless as to make it unconscionable for Halliburton to bear its legal expense."

In Halliburton the case was filed to obtain a declaratory judgment of invalidity and there was a counterclaim for infringement. The patent was declared invalid, and, accordingly, the result was the opposite of that here. Halliburton started the litigation because it wanted to test the patent, and it was not forced into the litigation by Dow's conduct. The exact opposite is true here. The gauntlet in this case was thrown by Johns-Manville when it copied plaintiff's patented luminaire without any investigation of the patent's validity or scope. Holophane and the Holophane Division had been trying for years to design a workable indirect fixture which could use an HID lamp in a low ceilinged room. Holophane engineers had failed completely. Business was falling off, and when the Florida school job came up, Holophane's sales department started scurrying about to sell something which met the architect's specifications and those specifications named the Luxxtra fixture. Holophane took a calculated risk when it copied Luxxtra. Classpak is sufficiently close to a carbon copy that the curvature of the bowls differs so little that a full scale drawing made with a sharp pencil can hardly differentiate between the lines of the two bowls. There was no investigation of patent coverage before defendant lunged into production of the copied fixture, and the predatory bidding which followed was nothing more than additional evidence that Mr. Big was going to destroy Mr. Little. Direct evidence to support my suspicion is not in the

record, but I suspect that counsel for defendant was pushed into an untenable position by the unthinking determination of the sales department to have manufactured the fixture its engineering department hadn't thought up. From sad experience, I know that clients can put lawyers in tough spots, and I am sure that had the legal department been contacted early on, the copying and production wouldn't have been quite as blatant and reckless. After it was too late, the matter was put into the hands of the legal department, and all the lawyers thought they could do was to stonewall. They stonewalled through a demonstration put on in Boston by the plaintiff and they stonewalled a claim that they weren't liable because their bowl was parabolic — a position I thought they maintained until final argument. Be that as it may, after being notified of the situation, defendant adopted that which is to me an unreasonable stance of defiance, and, although it does not appear in these exact words in the record, I think it apparent that defendant's thinking was that the pygmy plaintiff couldn't fight the giant defendant. The record shows a threat by defendant that the lawsuit would cost plaintiff $150,000.00 and it may have. It is not a sin to be big, and corporations shouldn't lose lawsuits because they are big. But, it isn't a sin to be little either, and utilization of unequal economic power to oppress or to block off litigation is a form of unfairness which cannot be tolerated. Commercial piracy can be profitable and it can be expensive to the bucaneer. *[sic]* This case comes down on the expensive side. I agree with and I adopt the language of Saf-Gard Products, Inc. v. Service Parts, Inc. (1974) D.C. Ariz. 370 F.Supp. 257, 181 USPQ 297:

> "Because said Defendant has 'faithfully copied' plaintiff's patented device, the defendant's infringing conduct being intentional, willful, and in complete disregard of plaintiff's patent rights makes this litigation exceptional within the meaning of Title 35 U.S.C. § 285.
>
> "In the instant case 'the infringer from the outset took a completely untenable position on the validity of the patent.' * * * The instant case is an exceptional one within the meaning of 35 U.S.C. § 284 and 285." *[sic]*

I think that this case is exceptional under the meaning of 35 U.S.C. § 285, and I think that plaintiff's attorney's fees should be paid by defendant because of its reckless, oppressive conduct.

35 U.S.C. § 284 permits the award of three times actual damages. The cases say that damages should be trebled when infringement is deliberate, intentional or wanton. I am unable to see how the findings I have made as to the award of attorneys' fees can result in a refusal to treble the actual damages, and proven actual damages will be trebled when the amount is ascertained. Those damages will be ascertained somewhere down the road if the case is not reversed on appeal of this decision. No Rule 54(b) determination is necessary to permit appeal because this is a patent case, and an appeal from this phase of the case is an appeal of right. Attorneys fees are awarded, but the amount of the awarded fees can be fixed only after a full evidentiary hearing. As to whether those fees should be treated as costs or damages and when a hearing to fix the fees should be held I leave to the parties if they can agree on the procedure. I do this because my attention has been invited to no controlling procedural law on when the hearing should take place, and in the time available, I have found none.

Rule 52 requires that in cases tried to the court findings and conclusions be made. As permitted by the rule, this memorandum opinion is intended to constitute the findings and conclusions in this case. Able counsel have each submitted proposed findings and conclusions, and they are more skillfully drawn than are those which appear in this opinion. Adoption of findings prepared by counsel has been criticized, and I completely agree with the thinking of Judge Maris in Roberts v. Ross (1965) 3 Cir. 344 F.2d 747. See, also, United States v. El Paso Natural Gas Co. (1964) 376 U.S. 651. It has been suggested that in complex cases (especially patent cases) it may be more appropriate for a judge to rely on counsel for the language of the findings and conclusions. See, 9 Wright and Miller, Federal Practice and Procedure § 2578. I disagree with this thinking and I suggest that failure of a judge to articulate his or her own findings is more dangerous in complex cases (especially patent cases) than it is in any other type of litigation. I, and most other judges, struggle with the evidence and the law in patent litigation to a degree unthought of in a routine automobile accident case. I think that the least the parties are entitled to is an exposition of the judge's understanding vel non of the facts and the law. A lawyer with training in patent law can write much more than can a judge who tries a patent case just once in a while, and that advocate will erect a stronger barrier against reversal than will a

trial judge. But, the findings which are lawyer-drafted have the potential of hiding a judge's lack of understanding of the facts and the law presented. So, contrary to the thinking of many trial judges, I refuse to adopt lawyer-prepared findings and conclusions, although I do read them to serve as a checklist of points raised.

I am nearing the end of this opinion. Rule 58 tells how judgments shall be entered, and it tells the point at which judgments become effective. It concludes, "attorneys shall not submit forms of judgment except upon direction of the court, and these directions shall not be given as a matter of course." I do not request counsel to prepare a form of judgment in routine cases or as a matter of course, but this is an unusual case. See, 11 Wright and Miller, Federal Practice and Procedure, § 2787. I think it not inconsistent to say that I will not adopt counsel's findings and to at the same time ask counsel to prepare a formal judgment consistent with this opinion. I do ask that counsel for plaintiff submit to opposing counsel and to the court a form of judgment within 10 days of the date of this opinion. If defendant's counsel objects to the proposed form of judgment, I ask that counsel attempt to resolve any differences of thinking as to form. If this cannot be done, defendant's counsel shall file written objections to the proposed judgment form within 10 days of the filing of plaintiff's proposed judgment. In the event such objections are filed, a hearing will be set to decide upon a form of judgment and to pass on any post trial motions.

# APPENDIX C

**NOVEMBER TERM — February 26, 1982**

Before Honorable Oliver Seth, Honorable William J. Holloway, Jr., Honorable Robert H. McWilliams, Honorable James E. Barrett, Honorable William E. Doyle, Honorable Monroe G. McKay, Honorable James K. Logan, and Honorable Stephanie K. Seymour, Circuit Judges

**No. 80-1060**

---

LAM, INC.,

*Plaintiff-Appellee,*

v.

JOHNS-MANVILLE CORPORATION and
JOHNS-MANVILLE SALES CORPORATION,

*Defendants-Appellants.*

---

This matter comes on for consideration of appellants' petition for rehearing and suggestion for rehearing in banc in the captioned cause.

Upon consideration whereof, the petition for rehearing is denied by the panel to whom the case was argued and submitted.

The petition for rehearing having been denied by the panel to whom the case was argued and submitted, and no member of the panel nor judge in regular active service on the Court having requested that the Court be polled on rehearing in banc, Rule 35, Federal Rules of Appellate Procedure, the suggestion for rehearing in banc is denied.

HOWARD K. PHILLIPS

By Robert L. Hoecker
Chief Deputy Clerk

# Opposition

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CLERK

No. 81-1869

# In the Supreme Court of the United States

OCTOBER TERM, 1981

JOHNS-MANVILLE CORPORATION
AND
JOHNS-MANVILLE SALES CORPORATION,
PETITIONERS,

*v.*

LAM, INC.,
RESPONDENT.

## RESPONDENT'S BRIEF IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE TENTH CIRCUIT

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# In the
# Supreme Court of the United States

OCTOBER TERM, 1981

No. 81-1869

JOHNS-MANVILLE CORPORATION
AND
JOHNS-MANVILLE SALES CORPORATION,
PETITIONERS,
*v.*
LAM, INC.,
RESPONDENT.

## RESPONDENT'S BRIEF[1] IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI

Respondent LAM, INC. respectfully requests that this Court deny the petition for writ of certiorari seeking review of the Tenth Circuit's judgment in this case.

### Reasons Why The Writ Should Be Denied

I. The alleged conflict among the circuits appears to be moot because of the newly authorized Court of Appeals for the Federal Circuit.

II. The reversal urged by petitioners as to the "basic claim" (Claim 4) will not change the effect of the decree below since Claims 8 and 9 were also held valid and infringed by petitioners' lighting fixture.

[1] References used in this brief will be to those appearing in the Petition: App. A (Court of Appeals Opinion); App. B (District Court Opinion); and to the Appendix on Appeal, App. VII.

III. The court of appeals correctly analyzed the Patent Office prosecution history of Claim 4.

IV. The decision of the court of appeals in this case is not in conflict with the cases from other circuits cited by petitioners.

V. The award of treble damages and attorneys' fees, treated as a footnote by petitioners in their QUESTIONS PRESENTED, does not present a substantial federal question.

## I. The Alleged Conflict Among The Circuits Appears To Be Moot Because Of The Newly Authorized Court Of Appeals For The Federal Circuit.

The basis for the petition, an alleged conflict among the courts of appeal on the doctrine of file wrapper estoppel, now appears to be moot, at least prospectively. Public Law 97-164, April 2, 1982 (Addendum A), authorizes a new Court of Appeals For The Federal Circuit which will review all future appeals from the district courts in patent cases. § 127. The act is effective October 1, 1982. § 402.

In view of the new legislation governing future patent appeals, this petition is analogous to one arising under a statute that has since been repealed. In such cases the impact of the alleged conflict is confined to the case at bar and thus does not present an important question of federal law. Indeed, such circumstances have been found adequate to dismiss a writ of certiorari as improvidently granted. *Rice* v. *Sioux City Memorial Park Cemetery, Inc.*, 349 U.S. 70, 76-77 (1955).

The new Court of Appeals for the Federal Circuit has been brought into being for the express purpose, *inter alia*, of providing a body of uniform appellate decisional law in patent cases. There will be no shortage of cases in which that court can consider and develop the rule and resolve supposed conflicts. Since resolving the issues in file wrapper estoppel is so dependent upon the facts of each case, the development of the case law should be by the new court in the first instance.

## II. The Reversal Urged By Petitioners As To The "Basic Claim" (Claim 4) Will Not Change The Effect Of The Decree Below Since Claims 8 And 9 Were Also Held Valid And Infringed By Petitioners' Lighting Fixture.

Petitioners focus their attention on Claim 4 of the patent in suit, which they refer to as the "basic claim".[2] They assert that only lighting devices having a bowl with the precise mathematical shape described in Claim 4 (elliptical surface of revolution) can infringe that claim because the doctrine of file wrapper estoppel limits the enforcement of Claim 4 to its literal reading.

Petitioners neglect to state that the trial court held and the appeals court affirmed that Claims 8 and 9 of the patent in suit were valid and infringed by petitioners' lighting fixture (Petition App. B, p. 38a; Petition App. A, pp. 13a-14a). Petitioners do not urge that these determination were incorrect. Thus, even if this Court were to reverse the holding as to Claim 4, the effect of the decree would not be changed.

Claims 8 and 9 incorporate Claim 4 and therefore are "dependent". (Claims 8 and 9 are quoted at Petition App. B, p. 25a). Perhaps petitioners assumed that their arguments on Claim 4 also apply to these claims. However, the history of these claims shows clearly that the file wrapper estoppel alleged by petitioners cannot apply to either claim since both of these claims derived from original claims in the application as filed which were allowed by the patent examiner *before* the "elliptical surface" amendment was made to the basic claim.

### *The Substance of Claim 9 was Allowed Without any Amendment*

Claim 9 was never amended in any material way, its substance being identical and its language substantially iden-

[2] "This narrower claim, which was approved by the patent examiner, *id.*, constitutes the patent claim at issue in this case." Petition p. 5.

tical with application claim 7 as filed. See Addendum B for a line-by-line comparison.

The doctrine of file wrapper estoppel has no applicability unless there has been amendment during prosecution of the application in the Patent Office which narrows the claim in question. *Olympic Fastening Systems, Inc.* v. *Textron, Inc.*, 504 F.2d 609 (6th Cir. 1974) *cert. denied*, 420 U.S. 1004. *Akron Brass Co.* v. *Elkhart Brass Mfg. Co., Inc.*, 353 F.2d 704 (7th Cir. 1965). *Waring Products Corp.* v. *Landers, Frary & Clark*, 263 F.2d 160 (2d Cir. 1959). *Edward Valves, Inc.* v. *Cameron Iron Works, Inc.*, 286 F.2d 933 (5th Cir. 1961) *cert. denied*, 368 U.S. 833.

Since patent claim 9 was allowed without substantive amendment it is entitled under the doctrine of equivalents to a reasonably broad range of equivalents in view of the pioneering nature of the invention. As the district court put it:

> . . . In more technical terms, scientific testing established that the LUXXtra emitted more than 40% of the light at low angles, and based on known technology at the time of the patent, this was a tremendous achievement, the impact of which increases with the energy shortage. It is now possible for the first time to light rooms having ordinary ceiling heights with HID lamps. This is so because the low angle reflection permits the fixtures to be located closer to the ceiling than was ever before possible, and glare is reduced to the point that the lighting is excellent for working or reading. Moreover, not only is there almost a tenfold reduction in energy consumption, but fewer fixtures are required. App. B 339-349

The dimensional difference between the infringing reflector surface and a true ellipse was shown to be no more than a few thousandth's of an inch and the patented and infringing fixtures were indistinguishable in operation and result. As the court of appeals noted, App. A. p. 13a, footnote 5:

> In commenting on an independent laboratory's tests of the two fixtures, J-M's expert witness, Merle E. Kech, testified that "the resulting light output from a Holophane CLASSPAK and a LUXXtra reflector of this type are very similar, and they both serve in the same application to achieve the same end results." App. V 795.

Where substantially the same means operates in the same way to achieve the same result infringement is clear. *Graver Tank and Mfg. Co.* v. *Linde Air Products Co.*, 336 U.S. 271 (1949)

*Claim 8*

The substance of claim 8 absent the "elliptical surface" limitation was allowed as application claim 5. App. VII 996; 1022. When the basic claim which became patent claim 4 was amended to include the "elliptical surface" limitation it became a limitation in patent claim 8 but not one related in any way to distinguishing prior art since application claim 5 had been indicated as allowable prior to such amendment. App. VII p. 1022. Hence, the "elliptical surface" amendment was not necessitated by a prior art rejection of patent claim 8.

## III. The Court Of Appeals Correctly Analyzed The Patent Office Prosecution History Of Claim 4

Claim 4 of the patent resulted from amendment of application claim 12; the first amendment October 9, 1970 "merely particularizing inner references" App. A, p. 16a; and a second amendment July 25, 1975 added the "elliptical surface" recitation *Id.*, 16a.

Petitioners allege that the second amendment was necessitated by prior art (Petition, p. 4) despite the fact that no rejection based on optical shape or any relevant prior art relating to the shape of the reflector surface was present. As stated by the court of appeals:

> . . .Nowhere in the patent examiner's rejection of the general luminaire claim does he suggest that he rejected the claim because of any relevant prior art relating to the shape of the reflector surface. *Id.*, 16a.

The amendment to the general luminaire claim which added the "elliptical surface" thus does not bring the claim so amended (claim 4) within the proscription of *Graham* v. *John Deere*, 383 U.S. 1, 33:

> Claims as allowed must be read and interpreted with reference to rejected ones and to the state of the prior art; and claims that have been narrowed in order to obtain issuance of a patent *by distinguishing the prior art* cannot be sustained to cover that which was previously by limitation eliminated from the patent. (emphasis added)

This conclusion is supported by the court's recognition that claims which at that time did *not* have the "elliptical surface" limitation were allowable by the examiner:

> "At the same time the examiner said he would allow the dependent claims if Lam redrafted them to include the basic claim's limitations" App. A, p. 16a.

Petitioners misstate the facts and completely misperceive the import of this combination of the examiner's prior art rejection which did not concern itself with the shape of the reflector and his simultaneous acknowledgement that claims without the "elliptical surface" limitation were allowable. After noting the prior art rejection, petitioners state (Petition p. 4):

> The examiner concluded that *the device described in respondent's application* was 'unpatentable over either

> Einstein or Schaffer of record taken alone or especially in view of Ainsworth newly cited because of obviousness under 35 USC § 103'. (emphasis added)

This is factually wrong since the examiner in the same communication held certain non-elliptical surface claims to be allowable.

As noted, the examiner was willing to allow claims without the "elliptical surface" limitation and the court of appeals duly noted that

> . . . Lam is not estopped from arguing equivalency. App. A, p. 13a.

and concluded:

> Therefore, Lam is not estopped from asserting that a parabolic or similar reflector surface infringes its patent. *Id.*, 16a.

From this review of the decision it is clear that the court of appeals did not err in interpreting the patent examiner's action as Petitioners allege.[3]

---

[3] Petition: p. 8
"The court evidently believed, however, that the patent examiner had erred . . ."; *Id.*, p. 9 "The Tenth Circuit's substitution of its own judgment . . ."; *Id.* ". . . second guess the patent examiner . . ."; *Id.*, p. 12 ". . . refused to accept the patent examiner's own stated basis . . . substituted its own contrary view . . ."; *Id.*, p. 13 ". . . second guessing the examiner . . ."; *Id.* ". . . substituting its own judgment . . ."; *Id.*, p. 14 ". . . second guess the basis for the patent examiner's actions . . ."

## IV. The Decision Of The Court Of Appeals In This Case Is Not In Conflict With The Cases From Other Circuits Cited By Petitioners.

Petitioners assert that the decision of the court of appeals in this case is inconsistent with cases cited from other courts of appeal in two respects. First, they state:

> The Tenth Circuit's substitution of its own judgment for that of the patent examiner concerning the proper basis for rejection of respondent's patent claim conflicts with the refusal by the courts in *Nationwide Chemical Corp.* v. *Wright*, 584 F.2d 714 (5th Cir. 1978), and *Ekco Prods. Co.* v. *Chicago Metallic Mfg. Co.*, 347 F.2d 453 (7th Cir. 1965), to second-guess the patent examiner in similar circumstances. (Petition, p. 9)

Second, they state that

> The Tenth Circuit's holding that the doctrine of file wrapper estoppel is available only where there has been a rejection based upon unpatentability because of prior art is in conflict with the more liberal scope afforded that doctrine in *Motorola, Inc.* v. *United States*, 209 U.S.P.Q. 769 (Ct. Cl. 1980), *Coleco, Ind., Inc.* v. *United States Int'l Trade Comm.*, 573 F.2d 1247 (C.C.P.A. 1978), and *Borg-Warner Corp.* v. *Paragon Gear Works, Inc.*, 355 F.2d 400 (1st Cir. 1965), *cert. dism'd.*, 384 U.S. 935 (1966). (Petition, p. 9)

Proper examination of the facts in this case and the holding in the cases cited shows that no conflict exists.

Petitioner's assertion that the Tenth Circuit substituted its own judgment for the patent examiner is incorrect. As noted, *supra*, the Tenth Circuit carefully examined and accepted the

patent examiner's findings. The patent examiner did not reject the basic claim by simply referring to the Einstein, Schaffer, and Ainsworth patents. Instead, he described the prior art as teaching use of a "reflective upwardly opening bowl. . . shaped in a manner to prevent radiation. . . from being directly emitted substantially below the horizontal plane of the bowl's upper lip. . ." App. VII, 1021. The Tenth Circuit accepted this finding and paraphrased it in stating

> We believe this finding means only that prior art teaches use of an indirect fixture to avoid direct emission below the horizontal. (Petition App. A, p. 16a)

Because the addition of language describing the shape of the bowl had no relation to the prior art teaching as determined by the patent examiner, the Tenth Circuit reviewed the file wrapper and concluded that the additional "elliptical surface" language was added to overcome vagueness or uncertainty, not prior art. (Petition App. A, p. 16a) As noted, *supra*, the Tenth Circuit, correctly applied the doctrine of file wrapper estoppel as described by this court in *Graham* and, as will be shown, none of the three cases cited by petitioners is in conflict with the Tenth Circuit's decision in this case as it has interpreted the doctrine consistent with *Graham*.

Under very similar circumstances, one of the three cited cases describes and applies the very approach used by the Tenth Circuit in this case on the question of file wrapper estoppel. In *Borg-Warner Corp.* v. *Paragon Gear Works, Inc.*, 355 F.2d 400 (1st Cir. 1965), *cert. dism'd*, 384 U.S. 935 (1966), the First Circuit considered the enforceable scope of claims in a patent concerning a rotary crescent gear pump. The holding of the First Circuit is so germane to this case that we quote it as follows:

> In our opinion the determinative factor should be not the reason why a change was required by the Patent Of-

> fice, but what, in fact, was surrendered. If, in the case at bar, the length of the ports, in degrees, and the rotation, had originally been described as "between 90° and 180°" and, upon the examiner's insistence, this had been changed to substantially 180°," it should make no difference whether his reason was an alleged conflict with prior art or alleged insufficient definiteness. In either event a subsequent party, examining the file to make sure that his own device, with parts extending 109° and 203° and having a rotation of 127½°, would not infringe, would discover that so broad a scope had been affirmatively disclaimed. The patentee, accordingly, should be estopped to recapture it.
>
> The supposed example, however, is not the case at bar. Review of the file wrapper as a whole discloses that the examiner's objection was that amounts were not indicated at all, i.e., that the invention was described only in terms of function. See fn. 8, supra. Hence when Seavey furnished details, although he was necessarily incorporating limitations, he gave up only an undescribed device. In these circumstances by asserting equivalence the plaintiff is not seeking to recapture what had been abandoned, because nothing had been abandoned. The claims, in other words, stand as claims initially made, entitled to the ordinary range of equivalents. [citations omitted] (355 F.2d at 406)

Neither of the other two cases cited by petitioners as conflicting with the Tenth Circuit in this case concerned similar factual circumstances. In *Coleco Ind., Inc.* v. *United States Int'l Trade Comm., supra*, the court held that an admission by the patentee arguing a narrow construction of claims may be a basis for file wrapper estoppel. Unlike *Coleco*, no such admission exists in the present case. *Motorola, Inc.* v. *United States, supra*, is an extremely technical case involving claims in a

patent for a radar transponder. The doctrine of file wrapper estoppel was applied only to two claims and one of the alleged infringing transponders. Like *Coleco*, one claim was limited by file wrapper estoppel because of specific admissions distinguishing the device sought to be patented from other specific patents. (209 U.S.P.Q. at 777). A second claim was limited by file wrapper estoppel because it was amended in direct response to the patent examiner's comment "that the connections between the second means (which contain the pulse delay means) and the gate means were not particularly pointed out." (209 U.S.P.Q. at 775). In contrast, the "elliptical surface" amendment in the present case was not directed at any specific comment of the patent examiner.

Furthermore, these latter two cases are found in the Court of Customs and Patent Appeals (*Coleco*) and The Court of Claims (*Motorola*). Public Law 97-167 abolishes the Court of Customs and Patent Appeals (§ 122). It also changes The Court of Claims to the United States Claims Court so that it is no longer a comparable appeals court with which a conflict can exist (§ 123). Thus, no conflict can exist after October 1, 1982, the effective date of Public Law 97-164 (§ 402), because the courts involved in *Coleco* and *Motorola* will no longer exist as appellate courts.

## V. The Award Of Treble Damages And Attorneys' Fees, Treated As A Footnote By Petitioners In Their QUESTIONS PRESENTED, Does Not Present A Substantial Federal Question.

The Tenth Circuit affirmed the district court's award of treble damages and attorneys' fees. (Petition App. A, pp. 17a-20a). An award of attorneys' fees, like an award of treble damages, is committed to the discretion of the trial court and may only be disturbed for abuse of discretion. *St. Regis Paper*

*Co.* v. *Royal Industries*, 552 F.2d 309, 316 (9th Cir. 1977), *cert. denied*, 434 U.S. 996 (1977); *Bolt Beranek & Newman, Inc.* v. *McDonnell Douglas Corp.*, 521 F.2d 338, 344 (8th Cir. 1975), *cert. denied*, 423 U.S. 1073 (1976); *Garrett Corp.* v. *American Safety Flight Systems, Inc.*, 502 F.2d 9 (5th Cir. 1974).

In addition, the innocent picture painted by petitioners for their activities is not supported by the record, the district court's findings, or the Tenth Circuit. The district court found that petitioners copied Lam's lighting fixture which embodied the patent. (Petition, App. B, pp. 34a-35a, 38a). Lam's brochure used by petitioners described its lighting fixture in part by including a large cut-away photograph which showed the bowl's curvature. App. VII p. 1037c It is no wonder that the petitioner's fixture had "remarkable similarities" to Lam's fixture. (Petition, *Id.*, 34a). Furthermore, the copying is shown by the optical performance of petitioner's lighting fixture which is clearly equivalent to Lam's fixture. (*Id.*, 38a). Indeed, the evidence that was presented showed that the precise curvature of petitioner's reflecting bowl (arcs of two circles) approximated a true ellipse having the focal points described in the patent to within a few thousandths of an inch. The intent of the copying was to make a "similar" fixture to Lam's which could be specified as equivalent. *Id.*, p. 34a

## Conclusion

For the reasons stated the petition for writ of certiorari should be denied.

Respectfully submitted,

May 6, 1982

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## ADDENDUM A

## ADDITIONAL STATUTE INVOLVED

Public Law 97-164 (April 2, 1982), in pertinent part provides:

> § 122. (a) Chapter 53 of title 28, United States Code, and the item relating to chapter 53 in the chapter analysis of part III of such title, are repealed. . . [abolition of United States Court of Customs and Patent Appeals]
>
> § 123. Sections 1255 and 1256 of title 28, United States Code, and the items relating to sections 1255 and 1256 in the section analysis of chapter 81 of such title, are repealed. [abolition of Supreme Court jurisdiction from decisions of The Court of Claims and Court of Customs and Patent Appeals]
>
> § 127. (a) Chapter 83 of title 28, United States Code, is amended by adding at the end thereof the following new sections:
>
> "§ 1295. Jurisdiction of the United States Court of Appeals for the Federal Circuit.
>
> "(a) The United States Court of Appeals for the Federal Circuit shall have exclusive jurisdiction—
>
> "(1) of an appeal from a final decision of a district court of the United States, the United States District Court for the District of the Canal Zone, the District Court of Guam, the District Court of the Virgin Islands, or the District Court for the Northern Mariana Islands, if the jurisdiction of that court was based, in whole or in part, on section 1338 of this title, except that a case involving a claim arising under any Act of Congress relating to

copyrights or trademarks and no other claims under section 1338(a) shall be governed by sections 1291, 1292, and 1294 of this title."

## EFFECTIVE DATE

§ 402. Unless otherwise specified, the provisions of this Act shall take effect on October 1, 1982.

## ADDENDUM B

**Patent Claim 9 (which incorporates claim 4)**
**App. A, pp. 1a-2a**

4. A luminaire for a high intensity lighting device said luminaire comprising:

an upwardly opening reflective bowl, terminating in a substantially circular outer lip, the diameter of said reflective bowl being greater on the outer lip than at the lower end;

a base integrally disposed on the lower end of said bowl,

means for holding a high intensity lighting device substantially axially within said bowl and arranged so that the radiation which is emitted substantially below the horizontal plane of said outer lip will be reflected over said outer lip and

means to hold said bowl in a fixed spatial relationship relative to said lighting device,

the optical shape of said bowl being an elliptical surface of revolution, one focus of which is disposed at said light source and the second focus being disposed at a point over said outer lip of said bowl.

9. A luminaire according to claim 4

wherein substantially all radiation from said lighting device leaves the luminaire after no more than one reflection, thereby substantially eliminating trapping of the radiation with the luminaire or reflection through said lighting device.

**Original Application Claim 7 (which incorporates original claims 1 and 6) App. VII, pp. 996-7**

1. A luminaire for a high intensity lighting device adapted to be suspended from the ceiling, said luminaire comprising:

an upwardly opening reflective bowl, terminating in a substantially circular outer lip, the diameter of said reflective bowl being greater on the outer lip than at the lower end;

a base integrally disposed upon the lower end of said bowl;

means to hold said device substantially axially within said bowl and arranged so that the radiation which is emitted substantially below the horizontal plane will be reflected over said outer rim;

means to hold said bowl in a fixed spatial relationship, relative to said lighting device.

6. The luminaire according to claim 1

wherein substantially all of the light which emerges from the lighting device leaves the luminaire after no more than one reflection, thereby substantially eliminating trapping of the light within the luminaire or reflection through said source.

7. The luminaire according to claim 6 wherein

the optical shape is an elliptical surface of revolution and one focus thereof is at said lighting device and the second focus is located at a point over the outer lip of said bowl.

# Petitioner's Reply Brief

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No. 81-1869

IN THE

# Supreme Court of the United States

OCTOBER TERM, 1981

JOHNS-MANVILLE CORPORATION

and

JOHNS-MANVILLE SALES CORPORATION, *Petitioners*,

v.

LAM, INC., *Respondent*.

**On Petition For A Writ of Certiorari To The United States Court Of Appeals For The Tenth Circuit**

## REPLY MEMORANDUM

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**On Petition For A Writ of Certiorari**
**To The United States Court Of Appeals**
**For The Tenth Circuit**

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## REPLY MEMORANDUM

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1. The Tenth Circuit in this case held that "[t]he application of this doctrine [of file wrapper estoppel] . . . is limited to changes [in a patent claim] made to overcome rejections by the Patent Office for the reason that the claim was anticipated in prior art similarities." Pet. App. A, pp. 14a-15a, *quoting from Eimco Corp.* v. *Peterson Filters and Eng'r Co.*, 406 F.2d 431, 438 (10th Cir. 1968), *cert. denied*, 395 U.S. 963 (1969). That holding conflicts with the much broader view of file wrapper estoppel that was endorsed and applied in *Motorola, Inc.* v. *United States*, 209 U.S.P.Q. 769 (Ct. Cl. 1980), *Coleco Ind., Inc.* v. *United States Int'l Trade Comm.*, 573 F.2d 1247 (C.C.P.A. 1978), and *Borg-Warner Corp.* v. *Paragon Gear Works, Inc.*, 355 F.2d 400 (1st Cir. 1965). Although respondent attempts to suggest the absence of a true conflict, *see* Br. in

Opp. 9-11, its very discussion, especially of *Motorola* and *Coleco*, demonstrates that both the opinions and the results in those cases are incompatible with the narrow scope given to file wrapper estoppel in this case.

The courts of appeals plainly are in conflict. The only substantial question posed by respondent's opposition is whether the conflict should be resolved in this case. Respondent offers two reasons why this Court should let the conflict stand. Neither is persuasive.

a. Respondent suggests that enactment of Public Law 97-164, 96 Stat. 25, has rendered the conflict moot. The basis for this suggestion is respondent's assertion that the new Court of Appeals for the Federal Circuit, which is to be established under Public Law 97-164, will have exclusive appellate jurisdiction "in patent cases." Br. in Opp. 2. In fact, the new court's jurisdiction will extend only to patent infringement cases, *i.e.*, cases where the jurisdiction of the district court "was based, in whole or in part, on section 1338 of [title 28]." Section 127, Pub. L. 97-164. The doctrine of file wrapper estoppel is not confined solely to patent infringement cases. It may be asserted whenever the extent of a patent monopoly is at issue. For example, the doctrine not uncommonly is invoked as a defense against suits to recover patent royalties. *See, e.g., Arvin Industries, Inc.* v. *Berns Air King Corp.*, 525 F.2d 182 (7th Cir. 1975); *Adkins* v. *Lear, Inc.*, 67 Cal. 2d 882, 435 P.2d 321 (Cal. 1967), *vacated and remanded on other grounds*, 395 U.S. 653 (1969). Cases of that kind will continue to be adjudicated in the other courts of appeals and in the state courts. As a consequence, the existing conflict over the proper scope of file wrapper estoppel will persist and will continue to dictate different results for litigants in different circuits, unless this Court acts to settle the issue once and for all. Thus, this is not a case like *Rice* v. *Sioux City Memorial Park Cemetary, Inc.*, 349 U.S. 70, 76-77 (1955), where the intervening enactment of new

law foreclosed repetition of the question presented. The true analogue is *Jones* v. *Mayer Co.*, 392 U.S. 409, 417-18 n. 21 (1968), where the passage of new law affected only a portion of the legal universe with which the Court was concerned.

Respondent has misread Public Law 97-164 in another important respect as well. Respondent attempts to dismiss the conflict between the decision below and *Motorola* and *Coleco* on the ground that "Public Law 97-164 abolishes The Court of Customs and Patent Appeals [which decided *Coleco* ] . . . [and] changes The Court of Claims [which decided *Motorola* ] to the United States Claims Court so that it is no longer a comparable appeals court . . . ." Br. in Opp. 11. In fact, as is well known, Public Law 97-164 merges the existing Court of Customs and Patent Appeals with the Court of Claims to establish the new Federal Circuit. *See* sections 165 and 166, Pub. L. 97-164. It may be presumed that the new court will adopt the prior decisions of its two constituent predecessors. Thus, *Motorola* and *Coleco*, far from being relegated to obscurity, have effectively been established as the law of the land in patent infringement cases. Review of this case therefore is necessary not only to ensure that the existing conflict will no longer remain to do mischief in other contexts but also to protect petitioners from unfairly being treated differently from litigants in all subsequent patent infringement suits.

b. Respondent argues that its dependent patent claims 8 and 9 would survive even if the basic claim upon which they depend were limited by file wrapper estoppel. Br. in Opp. 3-5. That argument is completely bogus. If the basic claim is limited by file wrapper estoppel, the dependent claims are too: "[a] claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." 35 U.S.C. § 112. If a basic claim is not infringed, because of file wrapper estoppel or otherwise, there can be no infringement of

merely dependent claims. *See Micro-Acoustics Corp.* v. *Bose Corp.*, 493 F. Supp. 356, 365 (S.D.N.Y. 1980).

2. Respondent apparently concedes that, if the Tenth Circuit disregarded the patent examiner's own stated reason for rejecting respondent's basic claim, the judgment below not only conflicts with *Nationwide Chemical Corp.* v. *Wright*, 584 F.2d 714 (5th Cir. 1978), and *Ekco Prods. Co.* v. *Chicago Metallic Mfg. Co.*, 347 F.2d 453 (7th Cir. 1965), but was wrongly decided. *See* Br. in Opp. 8-9. Respondent argues that the Tenth Circuit did not in fact disregard the patent examiner's ground for decision, *see id.* at 5-7, 9, but it is clear that that is precisely what the court did. The patent examiner rejected respondent's basic claim as "unpatentable over either Einstein or Schaffer of record taken alone or especially in view of Ainsworth newly cited because of obviousness under 35 U.S.C. § 103." App. VII, 1021.[1] It was in the face of this explicit rejection for unpatentability because of prior art that respondent amended and limited its basic claim to cover only use of a reflecting bowl with an optical shape identified as an elliptical surface of revolution. *Id.* at 1028.[2] If the Tenth Circuit had not disregarded the patent examiner's stated ground for rejecting the claim, it would have been constrained, even under its own narrow view of file wrapper estoppel, to limit respondent's patent monopoly to the specific optical shape identified in the amended claim.

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[1] "App." refers to the appendix filed in the court of appeals.

[2] Respondent suggests that the patent examiner had been willing to allow certain dependent claims without regard to prior art. *See* Br. in Opp. 6. But those dependent claims covered only lighting fixtures with fluted reflecting bowls; they did not cover nonfluted bowls of the kind at issue in this case. *See* App. IV, 530.

For the reasons stated here and in the petition for a writ of certiorari, the petition should be granted.

Respectfully submitted,

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